TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1906.

No. 56.

THE UNITED STATES *EX REL.* GEORGE A. LOWRY AND PLANTERS COMPRESS COMPANY, PLAINTIFFS IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

FILED JUNE 23, 1905.

(19,813.)

(19,813.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1905.

No. 311.

THE UNITED STATES *EX REL.* GEORGE A. LOWRY AND PLANTERS COMPRESS COMPANY, PLAINTIFFS IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

INDEX.

	Page.
Transcript from supreme court of the District of Columbia	1
Caption	1
Petition for writ of mandamus	1
Exhibit A—Decision of examiners-in-chief on motion to dismiss appeal	5
B—Petition to Commissioner of Patents	9
C—Decision of Acting Commissioner of Patents	10
Rule to show cause	11
Marshal's return	11
Return of respondent Edward B. Moore	12
Replication	13
Amended petition	15
Exhibit C—Certified copy from Patent Office of petition of Geo. A. Lowry, filed November 29, 1904	16
D—Certified copy of decision of Commissioner of Patents, December 6, 1904	19

Page
Stipulation as to service of petition, &c. 21
Order granting writ of mandamus, &c. 22
Order allowing appeal 24
Præcipe for transcript on appeal 24
Clerk's certificate 24
Minute entry of argument, &c 24
Opinion 26
Judgment 26
Order granting writ of error 39
Order staying mandate 39
Writ of error 40
Bond on writ of error 40
Citation and service 40
Clerk's certificate 42

a

SUPREME COURT OF THE DISTRICT OF COLUMBIA.

THE UNITED STATES OF AMERICA ex relatione George A. Lowry and Planters Compress Company, Relators, *vs.* FREDERICK I. ALLEN, COMMISSIONER of Patents, Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, board of examiners in chief, in the United States Patent Office, Respondents.	No. 47053. At Law.

UNITED STATES OF AMERICA,
District of Columbia, ss:

Be it remembered that in the Supreme Court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

1 *Petition for writ of mandamus.*

Filed July 7, 1904.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA EX RELATIONE George A. Lowry and Planters Compress Company, *vs.* FREDERICK I. ALLEN, COMMISSIONER OF Patents, Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein and Thomas G. Steward, board of examiners in chief, in the United States Patent Office.	No. 47053. At Law.

In the matter of the petition of George A. Lowry and Planters Compress Company, assignee of said George A. Lowry, praying for a writ of mandamus.

And now into this honorable court, by their counsel, Oliver Mitchell and Edmund Wetmore, come George A. Lowry, of Chicago, Illinois, and Planters Compress Company, a corporation organized and existing under

the laws of the State of Maine, and respectfully ask leave of the court to file a petition, herewith exhibited, for a writ of mandamus to Frederick I. Allen, Commissioner of Patents, in the United States Patent Office, Edward B. Moore, Acting Commissioner of Patents, in the United States Patent Office, and S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, constituting a board of examiners in chief in the United States Patent Office, and pray the court to direct a rule to be issued to
2 the said parties to show cause on a day to be fixed by the court why a writ of mandamus should not issue, commanding said parties to cause to be reinstated and to reinstate and take jurisdiction of the petitioners' appeal, and consider and determine the same on the merits as prayed for, and the petitioners pray for such other relief as may be just.

Filed July 7, 1904.

Supreme Court of the District of Columbia.

Ex parte. 47053.

In the matter of the petition of George A. Lowry and Planters Compress Company, assignee of said George A. Lowry, praying for a writ of mandamus.

To the honorable Supreme Court of the District of Columbia.

The petition of George A. Lowry and Planters Compress Company, assignee of said George A. Lowry, respectfully shows:

I. That the said Planters Compress Company is a corporation duly organized and existing under and by virtue of the laws of the State of Maine, and has a principal place of business at Boston, Massachusetts, and that it is the sole owner of Letters Patent of the United States, No. 661475, for Bale of Fibrous Material.

II. That said letters patent were applied for by your peti-
3 tioner, Lowry, January 29, 1897, and before issue, said application was assigned to said Planters Compress Company, and the said Letters Patent, No. 661475, for Bale of Fibrous Material were issued to your petitioner, Planters Compress Company.

III. Upon information and belief that thereafter an interference was declared in the United States Patent Office between said letters patent and the application of William L. Spoon, serial No. 74985, for a bale of fibrous material, to which interference your petitioner Lowry was, by the authorities of the Patent Office, made a party.

IV. Upon information and belief that in accordance with the rules of practice in the Patent Office, promulgated by the honorable Commissioner of Patents, said Lowry, after the declaration of said interference, moved to dissolve said interference upon the several grounds set forth in Rule No. 122; that this motion was transmitted to the proper primary examiner who granted the same; that thereupon Spoon aforesaid appealed from this adverse decision to the board of examiners in chief, who affirmed the decision, from which adverse decision said Spoon appealed to the honorable Commissioner of Patents in person.

V. Upon information and belief that subsequently the said Spoon petitioned the Commissioner of Patents to remand the said interference to the primary examiner for reconsideration of the question of operativeness of the Spoon press to make the issue bale and for leave to file affidavits in support of operativeness.

VI. Upon information and belief that this petition was granted
4 and thereafter a hearing was had and the primary examination found the Spoon press operative to make the issue bale, if the press of Lowry was operative to make the issue bale, and reversed previous decisions dissolving the interference.

VII. Upon information and belief that thereupon your petitioner Lowry appealed from this decision adverse to his motion to dissolve the interference, to the board of examiners in chief, as provided in section 482 and section 4909 of the Revised Statutes of the United States; that this appeal was duly docketed and a date set by the board of examiners in chief for a hearing thereof.

VIII. Upon information and belief that thereafter said Spoon filed a motion to dismiss said appeal; that this motion was heard, and that on the 10th day of May, 1904, the board of examiners in chief rendered a decision (a copy of which is hereto annexed and made a part hereof) in which, for the reasons therein stated, the said board of examiners in chief holds that it has no jurisdiction to entertain said appeal, and therefore allows the motion of Spoon to dismiss the appeal.

IX. Your petitioners further show, as they are advised, that under and according to the laws of the United States governing such matters, namely, sections 475, 476, 482, 4904, and 4909 of the Revised Statutes of the United States, it was the duty of the said board of examiners in chief to entertain and decide your petitioners' appeal and the lawful right of your petitioners as parties to an interference to have the said appeal heard and decided.

5 X. Upon information and belief that subsequently to said decision of said board of examiners in chief your petitioner, Lowry, petitioned the honorable Commissioner of Patents to direct said board of examiners in chief to hear and determine said appeal of Lowry and for such other relief as to his honor might seem meet, a copy of which petition is hereto annexed and made a part hereof.

XI. Upon information and belief that subsequently the honorable Assistant Commissioner refused, by a decision rendered June 29, 1904, to grant said petition and declined to give your petitioners any relief, and a copy of said decision is hereunto annexed and made a part hereof.

XII. And your petitioners further show, as they are advised, that they have exhausted all means in the Patent Office to obtain their legal right of appeal under sections 482 and 4909 of the Revised Statutes of the United States.

Wherefore your petitioners pray that a writ of mandamus be granted by this honorable court commanding Frederick I. Allen, Commissioner of Patents, Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, constituting the board of examiners in chief, to cause to be reinstated and to reinstate and take jurisdiction of your petitioners' said appeal and to entertain and consider the merits thereof and decide the same upon the merits.

And your petitioners pray for such other relief as to this honorable court may seem meet and proper.

6 And your petitioners will ever pray, etc.

PLANTERS COMPRESS COMPANY,
By GEORGE T. FRANCIS,
Second Vice-President.

OLIVER MITCHELL,
EDMUND WETMORE,
Counsel for Petitioner, George A. Lowry.

A. V. CUSHMAN, *Solicitor.*

STATE OF MASSACHUSETTS, *Suffolk, ss.* } 47053.

George A. Lowry, being duly sworn, says that he is one of the petitioners above named, that he has read the foregoing petition and knows the contents thereof, and that the same is true of his own knowledge, except those matters therein stated to be on information and belief, and as to those matters he believes it to be true.

Before me,

[SEAL.] EVERETT E. KENT,
Notary Public.

BOSTON, *July 2, 1904.*

STATE OF MASSACHUSETTS,
Suffolk, ss.

George T. Francis, of lawful age, being duly sworn, says that he is the second vice-president of the Planters Compress Company, the petitioner above named, that he has read the foregoing petition and knows the contents thereof, and that the same is true of his own knowledge, except those matters therein stated to be on information and belief, and as to those matters he believes it to be true.

Before me,

[SEAL.] EVERETT E. KENT,
Notary Public.

BOSTON, *July 2, 1904.*

7 STATE OF MASSACHUSETTS,
County of Suffolk, ss:

Oliver Mitchell, being duly sworn, says that he is an attorney and counsellor at law and is one of the solicitors for the Planters Compress Company and George A. Lowry, petitioners above named, and that he has read the foregoing petition and knows the contents thereof, and that the matters of fact therein alleged are true of his own knowledge.

Before me,

ROBERT CUSHMAN,
[SEAL.] *Notary Public.*

8

Exhibit A.

Filed July 7, 1904.

47053.

No. 25704. U. S. Patent Office, May 10, 1904.

Before the examiners in chief, on appeal.

In the matter of the interference between the patent to George A. Lowry, No. 661475, granted November 6, 1900, on an application filed January 29, 1897, and the application of William L. Spoon, filed September 10, 1901, division of application filed October 24, 1896. Interference No. 21517. Improvements in Bales of Fibrous Material.

Mr. Oliver R. Mitchell for Lowry.

Mr. Cyrus Kehr for Spoon.

Motion to dismiss appeal.

This is a motion to dismiss an appeal taken by Lowry from a decision of the primary examiner on a motion to dissolve.

The history of the proceedings in this case, briefly stated, is as follows:

Lowry moved to dissolve the interference on the ground that the application of Spoon failed to disclose an apparatus operative to produce such a bale as called for by the issue of the interference.

The primary examiner decided that Spoon's device was inoperative.

9 On appeal the examiners in chief affirmed his decision.

Thereupon Spoon took an appeal to the Commissioner, by whom the case was remanded to the primary examiner for further consideration. Before the primary examiner affidavits were filed and the examiner came to the conclusion that Spoon's application did disclose an operative device, whereupon Lowry appeals to the examiners in chief from this decision of the primary examiner.

Rule 124 provides that "From a decision of the primary examiner affirming the patentability of the claim or the applicant's right to make the same no appeal can be taken."

On the face of the appeal it is apparent that under the rule we have no jurisdiction.

On behalf of Lowry, however, it is contended that the rule is invalid and void because inconsistent with law.

The section of the statutes relating to interference proceedings, and the only section which relates thereto except that providing for an appeal from the decision of the Commissioner to the Court of Appeals of the District of Columbia, is sec. 4904.

As to the conduct of an interference proceeding up to the determination of the question of priority of invention by the "primary examiner," there is no more therein than merely a direction to notify the parties and direct the primary examiner to proceed to determine the question of priority of invention. There being nothing in the Statutes to regu-

10 late the proceedings so authorized, it is consistent with the law that the proceedings shall be regulated by rules established under

the Revised Statutes, sec. 483, such rules having been provided. They include provisions for conducting an interference proceeding to determine the merits—that is, the question of priority of invention. They also include rules for determining the validity of adverse decisions made in interference proceedings on questions not involving the merits. The raising of other questions than that of priority of invention is, under those rules, by motions, and a rule provides for appeals from such adverse decisions on motions as follows:

"124. Appeal may be taken directly to the Commissioner from decisions of the primary examiner on all motions except the following: (1) On motions to dissolve which deny the patentability of applicant's claim; (2) on motions to dissolve which deny the right of an applicant to make the claim; (3) on motions involving the merits of the invention. Decisions on these motions, when appealable, go to the examiners in chief in the first mentioned, and upon such appeals the questions shall be heard inter partes.

"From a decision of the primary examiner affirming the patentability of the claim or the applicant's right to make the same no appeal can be taken."

In the case before us the appeal is taken by Lowry from the decision of the primary examiner that the application of Spoon discloses an apparatus practically operative to produce the bale called for by the issue.

The question of operativeness, whether raised by a motion in interference or ex parte proceedings, is essentially whether an applicant has furnished sufficient basis for the grant of a patent under sec. 4886. The only real parties to the proceeding are the Patent Office, acting
11 in the interest of the public, and the applicant whose application is in question. In consonance with this idea, for many years the applicant's contestant was not even allowed to appear at the hearing of an appeal from the adverse decision of the principal examiner upon questions of patentability or right to make the claim. This practice was changed by decision of the Commissioner in Westinghouse v. Duncan, C. R. 1893, p. 12; 66 O. G., 1005, and the rule was subsequently amended to conform to this decision. Even now the rule provides only that the hearing shall be inter partes. The question of operativeness is the same whether it occurs in the ex parte or the inter partes consideration of an application.

The statute, as we understand it, expressly limits the jurisdiction of the examiners in chief to revising and determining upon the validity of adverse decisions of the principal examiner, and from his favorable decision, whether made in ex parte or interference cases, we have no jurisdiction.

On behalf of Lowry, however, it is urged that the present sec. 4909 means that "every party to an interference may appeal from the decision of the principal examiner * * * to the board of examiners in chief."

The section reads as follows:

"Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal."

The construction which counsel for Lowry attempts to put upon
12 this section of the statutes seems to us to be in direct contradiction of the Revised Statutes, sec. 482, which defines the duties of the examiners in chief. We fail to find in the history of this section any indication of an intent by Congress to change the powers of this tribunal.

By the act of 1861 it was enacted that there should be appointed by the President three examiners in chief, whose duty it shall be, on the written petition of an applicant, to revise and determine upon the validity of decisions made by an examiner when adverse to the grant of letters patent, and also to revise and determine in like manner upon the validity of decisions of examiners in interference cases.

At that time there was no special examiner of interferences, but each examiner decided such interferences as included applications which had been assigned to him for examination.

This act was followed by the Patent act of 1870. This act provided that there should be in the Patent Office three examiners in chief (sec. 476), whose duties were defined by sec. 482 to be on "the written petition of the appellant to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases."

The substitution of the term "appellant" in place of "applicant" was evidently made for the sake of accuracy. In ex parte cases rejected for
13 failure to comply with the requirements of secs. 4886 and 4916 the appellant was always an applicant, but in interference cases, where one of the parties might have a patent, the appellant might be a patentee and not an applicant.

The sections of the statutes which provide for appeals to the examiners in chief are secs. 4904 and 4909.

Section 4904 provides as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged to be the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

The "primary examiner" in this section is the "examiner in charge of interferences" referred to in sec. 440 and sec. 4909.

Section 4909 has been quoted above.

Under sec. 4909 the decision of the primary examiner is the decision of the question of priority, and that is the only matter upon which appeal can be taken under this section of the Statutes. See Westinghouse v. Duncan, C. D. 1894, p. 170; 66 O. G., 1009, and Painter v. Hall, 83 O. G., 1803; C. D. 1898, p. 91.

This whole matter is discussed in this last decision, to which attention is particularly called, and in which it is stated:

"The motion to dissolve on the ground of nonpatentability or that

one of the parties has no right to make the claim is heard inter partes by the primary examiner as a matter of office policy in order that the facts and reasons which, in the opinion of the moving party, negative the patentability of the claim or show that his oppo ent is not
14 entitled to make the claim may be clearly presented; but the office does not and can not recognize the moving party as a party in interest entitled to contest the patentability of another's claims. He has no right to appeal from a decision denying his motion. His position is not unlike that of amicus curiæ, the same reasons which justify the rule which refuses the right of appeal from the decision of the primary examiner affirming patentability or the right of the respective parties to make the claim justify the office in refusing to permit the appeal taken by the party whose claims are affected to be made a contest inter partes before the appellate tribunal."

There are, of course, innumerable decisions denying the right of appeal from a favorable decision of the examiner. See, for example, White v. Thomson, 101 O. G., 2825; Fuller v. Brush, 16 O. G., 1188; Faure v. Bradley et al., 40 O. G., 243; Faure v. Bradley et al., 44 O. G., 945; ex parte Ferguson, 56 O. G., 1334; Kane v. Brill & Adams, 84 O. G., 1142; Miller v. Kelley, 84 O. G., 1144; Holt v. Ingersoll, 84 O. G., 1873; Stupakoff v. Johnson, 84 O. G., 982; Edison v. Stanley, O. D. 1891, 173; Sharer v. McHenry, 91 O. G., 1034; Meyer v. Sarfert, 96 O. G., 1037; Ross v. Scott, 96 O. G., 842; Niedermeyer v. Walton, 98 O. G., 1707.

As we understand the statute, it means that the examiners in chief are called upon (1) to determine upon the validity of adverse decisions of a principal examiner who has twice rejected the claims of an application for patent; (2) adverse decisions of a principal examiner who has
15 twice rejected the claims of an application for reissue of a patent (sec. 4909); and (3) decisions of the examiner in charge of interferences upon the question of priority (secs. 4909 and 4909). If there had been any intent on the part of Congress to provide for appeals from favorable decisions of examiners, there would have been some express provision of the statutes to that end. There is no such provision; on the contrary, sec. 482 limits the jurisdiction of the examiners in chief to determining upon the validity of adverse decisions of examiners of all kinds.

Sec. 4909 provides for appeals from the primary examiner only when the claims have been rejected.

Secs. 4910 and 4911, and sec. 9 of the act of February 9, 1893, provide for appeals to various tribunals.

If Lowry's contention is correct, then every party to an interference may appeal from any decision of a primary examiner to the Court of Appeals.

The whole theory of action of the Patent Office under the clause of Rule 124, which provides for no appeal from a favorable decision of the examiners on a question affecting the rights of an applicant to make the claims and the patentability of the claims, and such questions as arise under secs. 4886 and 4916, is that in the ordinary course of procedure, if the primary examiner decides that the claims are allowable, there is no provision for a review of his favorable decision.

It has been regarded as the policy of the patent statutes to
16 grant a patent wherever any tribunal of the Patent Office found the claims of an application to be allowable. It seems to us incredible that if Congress had intended that this long-established policy should be changed merely because an applicant became involved in an interference the statutes should not have expressly provided for such a contingency.

Our conclusion is that Rule 124 is valid and in accord with the law, and accordingly we hold that we have no jurisdiction over the appeal taken by Lowry from the decision of the primary examiner, and the motion made by Spoon to dismiss the appeal of Lowry is granted and the appeal is accordingly dismissed.

J. H. BRICKENSTEIN,
S. W. STOCKING,
Examiners in Chief.

I am of the opinion that the appeal should be dismissed for lack of jurisdiction under the rules.

T. G. STEWARD,
Examiner in Chief.

17 EXHIBIT B.

Filed July 7, 1904.

IN THE UNITED STATES PATENT OFFICE.

GEORGE A. LOWRY
v.
WILLIAM L. SPOON. } 47053. Interference No. 25704.

Petition to the Hon. Commissioner of Patents.

Your petitioner, George A. Lowry, one of the parties to the above-entitled interference, respectfully represents that the above-entitled interference was declared Dec. 17, 1901; that upon motion by Lowry to dissolve, duly made and transmitted, the motion was allowed by the primary examiner, and upon Spoon's appeal to the examiners in chief from this decision the decision was affirmed, and from the decision of the examiners in chief Spoon appealed to the Hon. Commissioner. That pending this appeal the Commissioner, upon Spoon's petition, remanded the interference to the primary examiner for further consideration of the question of operativeness; that thereafter the primary examiner denied the motion to dissolve; that upon a petition of Lowry to transmit the interference to the board of examiners in chief for review of their previous decision, the Hon. Commissioner denied the petition and dismissed Spoon's preceding appeal to the Commissioner; that subsequently Lowry moved for rehearing; that this motion was allowed; that rehearing was
18 *was* had, and on the 21st day of March, 1904, the decision of the Commissioner of rehearing affirming his previous decision; that on the 8th day of April, Lowry appealed from the decision of the primary examiner to the board of examiners in chief under sections 482 of the

act of 1870 and under section 4909 of the Rev. Statutes of the United States; that this appeal was docketed by the board of examiners in chief and hearing set thereon for May 25, 1904; on April 20, 1904, Spoon moved to dismiss Lowry's appeal and that, May 10, 1904, the board of examiners in chief allowed the motion of Spoon.

Wherefore your petitioner prays that your honor will direct said board to perform the duty laid upon them by law, and for such other and further relief as to your honor may seem meet.

GEORGE A. LOWRY,
By his attorney, OLIVER MITCHELL.

19 EXHIBIT C.

Filed July 7, 1904.

Intf. No. 21517. N. L. M.
May 20, 1904. (E. E. G.)

UNITED STATES PATENT OFFICE.

Lowry v. Spoon. 47053.

Bale of Fibrous Material.

PETITION.

Patent granted George A. Lowry November 6, 1900, No. 661475.
Application of William L. Spoon filed September 10, 1901, No. 74985.
Division of application No. 609902, filed October 24, 1896.
Mr. Oliver R. Mitchell, for Lowry.
Mr. Cyrus Kehr, for Spoon.

This is a petition by Lowry, asking in effect that the examiners in chief be directed to hear and determine his appeal from the primary examiner's decision denying his motion to dissolve the above-entitled interference.

The motion was made on the ground that Spoon has no right to make the claim of the issue, since his device is inoperative. The examiner's decision was in favor of Spoon's right to make the claim, and
20 under the express provisions of rule 124 no appeal lies from his decision. Lowry recognizes this, but contends that the rule is inconsistent with the statute and is invalid. He calls attention to the fact that section 4909, R. S., is broad in its terms, saying "every party to an interference may appeal," and argues therefrom that he is entitled to appeal from any decision in an interference with which he is not satisfied. A similar contention was made before the Court of Appeals in Westinghouse v. Duncan, 66 O. G., 1009, and the court expressly ruled to the contrary, saying:

"In our opinion it was not the intention of Congress in the employment of the general terms of the statute, to grant the right of appeal to this court from mere interlocutory or preliminary orders or rulings in interference proceedings."

The court has further ruled that decisions upon motions to dissolve constitute interlocutory or preliminary orders, and in the recent case of

Mark v. Greenawalt, decided May 11, 1904, it dismissed for lack of jurisdiction an appeal from a decision on a motion holding that one of the parties had no right to make the claim of the issue.

The rule prohibiting an appeal from a decision upon a motion holding that a party has the right to make the claim of the issue is in accordance with the practice which has prevailed in this office for many years and has the support of all decisions of the courts which have been rendered on the subject. There seems to be no reason for regarding it as inconsistent with the statute. It seems very clear that the decision in this
21 case is not a final adverse decision, since it is not a ruling that Lowry is not entitled to his patent. That is a matter which may be determined in the further proceedings, and therefore it is clear that the decision relates to a mere interlocutory matter.

The petition is denied.

E. B. MOORE,
Acting Commissioner

22 *Rule to show cause.*

Filed, July 7, 1904.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA EX RELATIONE GEORGE A. LOWRY, ET AL. *vs.* FREDERICK I. ALLEN, COMMISSIONER OF PATENTS; EDWARD B. MOORE, ASSISTANT COMMISSIONER OF PATENTS; S. W. STOCKING, J. H. BRICKENSTEIN, THOMAS G. STEWARD, BOARD OF EXAMINERS IN CHIEF.	No. 47053. At law.

On reading the petition for the writ of mandamus in this cause and upon considering the same it is this 7th day of July, 1904, ordered: That the defendants show cause herein on the 18th day of July, 1904, at 10 o'clock a. m., before this court why the said writ of mandamus should not issue as prayed.

Provided that a copy of this order and petition be served on the defendants on or before the 9th day of July, 1904.

ASHLEY M. GOULD,
Associate Justice.

Marshal's return.

Served copy of within rule and copy of the petition in this cause on defendants as follows:
23 Frederick I. Allen, Commissioner of Patents, by service on Edward B. Moore, Acting Commissioner; Edward B. Moore, Assistant Commissioner of Patents; S. W. Stocking and J. H. Brickenstein, of the board of examiners in chief, July 7, 1904; on defendant Thomas G. Steward, of said board.

July 8, 1904.

AULICK PALMER, *Marshal.*
B.

Return of respondent Edward B. Moore.

Filed July 14, 1904.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA EX RELATIONE George A. Lowry and Planters' Compress Company *vs.* FREDERICK I. ALLEN, COMMISSIONER OF PATENTS; Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, board of examiners in chief, in the United States Patent Office.	No. 47053.	At law.

To the honorable the Justices of the Supreme Court of the District of Columbia:

The return of the respondent Edward B. Moore, Assistant
24 Commissioner of Patents, to the rule to show cause issued herein upon the 7th day of July, 1904.

The said Edward B. Moore, Assistant Commissioner of Patents, comes, and for answer to the order to show cause why the said writ of mandamus should not issue says, upon information and belief:

1. The respondent admits the allegations of the first paragraph of the petition.

2. The respondent admits the allegations of the second paragraph of the petition.

3. The respondent admits the allegations of the third paragraph of the petition.

4. The respondent admits the allegations of the fourth paragraph of the petition.

5. The respondent admits the allegations of the fifth paragraph of the petition.

6. The respondent admits the allegations of the sixth paragraph of the petition.

7. The respondent admits that Lowry filed an appeal to the examiners in chief from the decision of the primary examiner refusing to dissolve the interference, but denies that such appeal was provided for or authorized by sections 482 and 4909 of the Revised Statutes, or by any other section of the statutes.

8. The respondent admits the allegations of the eighth paragraph of the petition.

9. The respondent denies that it was the duty of the examiners
25 in chief to entertain and decide the petitioners' appeal and denies that the petitioners were entitled to have the appeal heard and decided. He avers that the primary examiner's decision was not the rejection of a claim or a final adverse decision in the interference, but was a mere ruling upon an interlocutory motion and was not appealable. He further avers that the decision was not adverse to Lowry's claimed rights as the patentee, since that is the very matter to be determined in the interference proceeding which the primary examiner refused

to dissolve. Lowry will have the right of appeal, if at all, only in case the final decision in the interference is adverse to him.

10. The respondent admits the allegations of the tenth paragraph of the petition.

11. The respondents admits the allegations of the eleventh paragraph of the petition.

12. The respondent admits that the petitioners have exhausted all means in the Patent Office to obtain the right of appeal from the interlocutory decision of the primary examiner at this time and avers that the right of appeal will not exist unless and until a final adverse decision is rendered in the interference.

The respondent further says that by reason of the facts hereinbefore alleged he should be dismissed with his reasonable costs.

EDWARD B. MOORE.

JOHN M. COIT, *Attorney.*

26 DISTRICT OF COLUMBIA, *ss:*

On this day personally appeared before me, a notary public in and for the said District of Columbia, Edward B. Moore, and made oath that he is the respondent in the above-entitled cause; that he has read the foregoing answer by him subscribed and knows the contents thereof; that the same is true of his own knowledge, except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true.

Given under my hand this 14th day of July, 1904.

[SEAL.] A. M. BUNN,
Notary Public for the District of Columbia.

Replication.

Filed July 26, 1904.

In the Supreme Court of the District of Columbia.

UNITED STATES EX REL. GEORGE A. LOWRY, and Planters Compress Company, *vs.* FREDERICK I. ALLEN, COMMR. OF PATS., Edward B. Moore, Asst. Comr. of Patents, S. W. Stocking, J. H. Brickenstein, Thomas G. Steward, board of exrs. in chf.	No. 47053. At Law.

To the Honorable Justices of the Supreme Court of the District of Columbia.

27 Replication of the relators to the answer of the respondents herein, filed upon the 14th day of July, 1904.

Now, into this honorable court comes the relators by counsel and, saving unto themselves all and every right of exception to the apparent insufficiencies of the answer of the respondents by way of replication to such answer, say:

1. The relators except to the allegations of the respondents in paragraph 9 of said return "that the primary examiner's decision was not a

rejection of a claim or a final adverse decision in the interference, but was a mere ruling upon an interlocutory motion" and say that such allegations are wholly immaterial and are not in issue in this case, for the reason that neither section 482 nor 4909 of the Revised Statutes of the United States nor any other statute requires that a decision to be appealable shall be "the rejection of a claim," nor that it shall be a "final" decision in an interference; nor does any rule of law or any statute of the United States provide that a ruling, "mere" or otherwise, upon an interlocutory motion is not or shall not be appealable, provided that the decision affects the substantial rights of the parties or is not otherwise reviewable, and the allegations of the respondents are therefore insufficient in law to be replied unto; and the relators aver that the action of the primary examiner was a decision, and that the decision and denial of the primary examiner touched and affected a substantial right, and that unless reviewed by the respondents the board of examiners in
28 chief, as required by the relators, no review can hereafter be had; and the relators aver that on other interlocutory questions raised by motions to dissolve under rule 122 the Patent Office allows the right of appeal to both parties, namely, on motions to dissolve on the ground that no interference in fact exists, and upon motions to dissolve for irregularity in declaring the interference, and also upon motions to shift the burden of proof, and all other interlocutory motions.

2. Further replying, the relators deny the allegation contained in paragraph 9 in said reply, "that the decision was not adverse to Lowry's claimed rights as a patentee," and deny the allegation that "that is the very matter to be determined in the interference proceeding which the primary examiner refused to dissolve," and allege that the first and fundemental question to be determined in any interference is that the parties alleged to interfere have the same invention, and that such a matter is not "the very matter to be determined in the interference proceedings which the primary examiner refused to dissolve," but that the only matter to be determined in the interference proceedings, if they be not dissolved, is the right of Spoon to a patent, since Lowry has already a patent, and your relators aver that a decision that an applicant has a right to claim your relator's patented invention is a decision adverse to your relators and affects his substantial interest; and your relators aver that unless the examiner's decision upon this question is reviewed at this stage of the proceedings, no review of the question of invention involved will be possible at any later stage.

29 And your relators aver that it is wholly immaterial whether or not the primary examiner's decision was an interlocutory matter, and whether or not such matters are not at common law appealable, since the relators' right is based upon statute, and whether that statute be declaratory or amendatory of the common law is immaterial.

Wherefore your relators do move the court for judgment and for the issuance of a peremptory writ of mandamus against the respondents notwithstanding the return of the respondents herein.

EDMUND WETMORE,
OLIVER MITCHELL,
A. V. CUSHMAN,
Attorneys for Relators.

In the Supreme Court of the District of Columbia.

UNITED STATES EX REL. GEORGE A. LOWRY and Planters Compress Company *vs.* FREDERICK I. ALLEN, COMMR. OF PATS., Edward B. Moore, Asst. Commr. of Patents, S. W. Stocking, J. H. Brickenstein, Thomas G. Steward, board of exrs. in chf.	No. 47,053. At Law.

CITY OF WASHINGTON,
District of Columbia, ss:

A. V. Cushman, being duly sworn, deposes and says that he is of mature age and a resident of Washington, District of Columbia.

30 That he is of counsel for George A. Lowry et al. in the matter of the above-entitled case.

That he has read the replication of the said George A. Lowry et al. to the answer of the respondents herein.

That the pleading as to matters of fact is of his own knowledge true, except as to matters therein stated upon information and belief, and as to these matters he believes the said replication to be true.

Further deponent sayeth not.

A. V. CUSHMAN.

Sworn to and subscribed before me this 26th day of July, 1904.

[SEAL.] H. J. SWEENEY,
Notary Public, D. C.

31 *Leave to amend petition.*

Filed December 29, 1904.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, EX RELATIONE, George A. Lowry, and Planters Compress Company, *vs.* FREDERICK I. ALLEN, COMMISSIONER OF PATents, Edward B. Moore, Assistant Commissioner of Patents, S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, board of examiners in chief in U. S. Patent Office.	No. 47053. At law.

And now into this honorable court, by their counsel, comes George A. Lowry, of Chicago, Illinois, and Planters Compress Company, a corporation organized and existing under the laws of the State of Maine, and pray leave of the court to amend their petition herein as follows, the amendments being agreed to by counsel for the respondents:

1st. In the second line of the 11th paragraph of said petition, after the word "Honorable" insert "Acting."

2nd. By inserting after paragraph XI the following:

XIa. Upon information and belief, that subsequently to said decision of said board of examiners in chief, and subsequently to said decision of said honorable Acting Commissioner, your petitioner, Lowry,
32 petitioned the honorable Commissioner of Patents to direct said board of examiners in chief to hear and determine said appeal of Lowry, and for such other relief as to his honor might seem meet, a certified copy of which said petition is hereto annexed and made a part hereof, as Exhibit C.

XIb. Upon information and belief, that subsequently, the honorable Commissioner refused, by a decision rendered December 6, 1904, to grant said petition and declined to give your petitioner any relief, a certified copy of which said decision is hereunto annexed and made a part hereof, as Exhibit D.

H. A. CUSHMAN.
Solicitor for Petitioner.

OLIVER MITCHELL,
EDMUND WETMORE.
Counsel.

The respondents herein consent to the aforesaid amendments.

JOHN M. COIT,
Counsel for Respondents.

33 EXHIBIT C.

UNITED STATES OF AMERICA,

DEPARTMENT OF THE INTERIOR,

PATENT OFFICE.

To all persons to whom these presents shall come, greeting:

This is to certifiy that the annexed is a true copy from the records of this office of the petition of George A. Lowry, filed November 29, 1904, in the matter of—

Interference. Number 21517, Lowry *vs.* Spoon. Subject-matter: Bale of Fibrous Material.

In testimony whereof, I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the city of Washington, this 20th day of December, in the year of our Lord, one thousand nine hundred and four and of the Independence of the United States of America the one hundred and twenty-ninth.

[SEAL.]

F. I. ALLEN,
Commissioner of Patents.

34 Intf. No. 21517, paper No. 90.

IN THE UNITED STATES PATENT OFFICE.

IN RE INTERFERENCE LOWRY
v. } No. 21517.
SPOON, BALE OF FIBROUS MATERIAL.

Before the honorable Commissioner of Patents.

Now comes George A. Lowry, by counsel, and respectfully represents unto your honor:

That on or about the 5th day of Feb., 1902, he filed a motion to dissolve the above-entitled interference.

That on or about the 23rd day of May, 1902, the primary examiner rendered a decision granting said motion to dissolve the interference.

That on or about the 14th day of June, 1902, Spoon, the opposing party in the interference, appealed to the board of examiners in chief from the decision of the primary examiner granting Lowry's motion to dissolve.

That on or about the 15th of October, the board of examiner' in chief rendered a decision affirming the primary examiner's decision granting Lowry's motion to dissolve.

That on or about the 21st day of November, 1902, Spoon filed a petition asking your honor to remand the interference to the primary
35 examiner to rehear Lowry's motion to dissolve and consider new evidence on the question of the operativeness of his (Spoon's) machine to make the bale of the interference issue.

That on or about the 29th day of November, 1902, your honor granted Spoon's petition to remand.

That on or about the 27th day of July, 1903, the acting primary examiner, on rehearing, denied Lowry's motion to dissolve, overruling the decisions aforesaid of the primary examiner and the board of examiners in chief granting Lowry's said motion to dissolve.

That thereafter the said interference was before your honor on petitions, appeals, and motions, filed on behalf of both parties and arising out of the action of the acting primary examiner in denying Lowry's said motion to dissolve.

That on or about the 8th day of April, 1904, and as soon as he could properly and lawfully do so, he (Lowry) filed an appeal from the acting primary examiner's decision denying his motion to dissolve the interference to the board of examiners in chief, in accordance with the law (sect. 482 of the act of 1870, and sect. 4909 of the Rev. Statutes U. S.) in such cases made and provided.

That on or about the 19th day of April, 1904, a motion to dismiss Lowry's aforesaid lawful appeal to the board of examiners in chief was filed by Spoon, the opposing party in the above entitled interference.

That on or about the 10th day of May, 1904, the said board of examiners in chief did dismiss Lowry's appeal, aforesaid, notwithstanding his lawful right to have such appeal entertained, heard, and decided upon the merits.

36 That on or about the 12th day of May, 1904, he (Lowry did appeal to the honorable Acting Commissioner of Patents asking

that the Acting Commissioner direct the board of examiners in chief to entertain, hear, and decide the aforesaid lawful appeal of Lowry, wrongfully dismissed by them, and to grant such other relief as seemed proper.

That on or about the 29th day or June, 1904, the honorable Acting Commissioner rendered a decision refusing the relief prayed for and refusing to direct the board of examiners in chief to entertain, hear, and decide Lowry's lawful appeal to them.

Wherefore Lowry appeals to your honor in person, and prays that a review of the decisions below denying Lowry his lawful rights be made by your honor, that the board of examiners in chief be directed to entertain, hear, and decide Lowry's appeal aforesaid in conformity with the law in such cases made and provided, and for such other relief as may seem proper to your honor.

Respectfully,

GEORGE A. LOWRY,
By OLIVER MITCHELL,
Attorney.

NOVEMBER 29, 1904.

37 In re Intf. No. 21517, Lowry vs. Spoon. Bale of Fibrous Material.

Affidavit of service.

CITY OF WASHINGTON,
District of Columbia:

A. V. Cushman, being first duly sworn, deposes and says that he is of lawful age and a resident of the city of Washington, in the District of Columbia; that he has this day made service of the proceeding on behalf of George A. Lowry, in the above-entitled interference upon William L. Spoon, the opposing party, by forwarding to Cyrus Kehr, Empire Bldg., Knoxville, Tenn., attorney of record for Spoon, by registered mail, postage prepaid, a true and signed copy of the prayers of Lowry to the Commissioner of Patents filed herewith, and in support of the averments in this affidavit he has attached hereunto the registry receipt from the receiving office at Washington, D. C.

A. V. CUSHMAN.

Subscribed and sworn to before me this 29th day of November, 1904.

[NOTARIAL SEAL.]

A. M. BUNN,
Notary Public for D. C.

38 *U. S. P. O. registry receipt.*

Letter parcel No. 32647, P. O., Washington, D. C., Station G.
Received for registration 11/29, 1904, from A. V. Cushman.
Addressed to Cyrus Kehr, Knoxville, Tenn.
——— class postage prepaid. Postmaster, per R. H.

39 EXHIBIT D.

United States of America.

DEPARTMENT OF THE INTERIOR, PATENT OFFICE.

To all persons to whom these presents shall come, greeting:

This is to certify that the annexed is a true copy from the records of this office of the decision of the Commissioner, dated December 6, 1904, in the matter of—Interference. Number 21517. Lowry vs. Spoon. Subject-matter, Bale of Fibrous Material.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the city of Washington, this 20th day of December, in the year of our Lord one thousand nine hundred and four, and of the Independence of the United States of America the one hundred and twenty-ninth.

[SEAL.]

F. I. ALLEN,
Commissioner of Patents.

40 Nov. 16, 1904. No. 21517. M. H.

Intf. No. 21517, Paper No. 92. Commr's decision. Recorded, vol. 81, page 264.

United States Patent Office.

Lowry *v.* Spoon. Bale of fibrous material.

Petition.

Patent granted George A. Lowry November 6, 1900, No. 661475. Application of William L. Spoon filed September 10, 1901, No. 74985.

Mr. Oliver R. Mitchell and Mr. A. V. Cushman for Lowry.

Mr. Cyrus Kehr for Spoon.

This is a petition by Lowry that the examiners in chief be instructed to hear and determine on its merits his appeal from the decision of the primary examiner denying his motion to dissolve the above-entitled interference.

The motion for dissolution was made on the ground that Spoon's application furnished no proper basis for the claims, in that his device as disclosed was inoperative. The examiner decided that Spoon's device was not inoperative as described in his application, and that therefore
41 there was no bar against the allowance of his patent independent of such bar as might be shown by the evidence produced in the interference. His judgment therefore was that the interference should not be dissolved, but should proceed so that the rival claims of the parties could be determined.

Under the express provisions of Rule 124 there is no appeal to the examiners in chief from such decision rendered on an interlocutory motion. It is believed that there is nothing in that rule inconsistent with law, and that therefore it has the force of law. The right of appeal in interferences given in general terms in the statute is a very different

thing from the right of appeal on all motions in the interference. To permit appeals on motions would multiply litigation and extend the proceedings in interferences beyond all reasonable limits. It would work great hardship to parties. The appellate tribunals of this office are no more required to give cases piecemeal consideration than are the appellate courts. The whole case should be ready for appeal when the appeal provided for by the statute is taken. There seems to be no reason whatever for regarding the statute as having a different meaning. Similar statutes relating to appeals in the courts are universally so construed, and there seems to be no good reason for applying a different rule of construction here. There are the same objections to the piecemeal consideration of cases here as in the courts, and there seems to be no good reason for concluding that Congress intended to impose that burden upon this office and upon applicants for patents which it does not impose upon the courts and litigants there. There is nothing in the wording of the statute which seems to warrant the conclusion, and, on the contrary, the provision
42 for an appeal in these very cases to the Court of Appeals would seem to show conclusively that the same rule was intended to apply as in the courts. The wording of the statute providing for appeal to the Court of Appeals is almost identical in terms with that providing for the preceding appeals in this office, and that court has expressly decided that decisions on motions like that made in this case are not appealable to it.

It is to be particularly noted that there has been no decision as to the rival claims of the parties to this interference. It has not been decided which party is entitled to the patent. If it should at any time be decided that Spoon is entitled to the patent, Lowry will have the right of appeal, but until such final decision is rendered the statute gives him no right of appeal.

It would seem upon general principles of law that Lowry could then present for determination by his appeal any question which in his opinion vitally affects the question which party is entitled to the patent. The only ground upon which he can reasonably claim the right of appeal on this motion is that the question vitally affects his claimed right to a patent, and if it does that, he can raise it at final hearing and contest it before the various appellate tribunals, including the Court of Appeals.

The refusal to permit the present appeal on motion is therefore not a denial of an opportunity to have the matter reviewed by the several appellate tribunals mentioned in the statute.

43 The suggestion by Lowry that the tribunals of this office may not after final hearing regard the question now raised as vital, and may not give it weight in deciding his right to a patent, surely does not furnish good reason for a consideration of it by the several appellate tribunals in advance of a final decision. Lowry will have cause for complaint when the examiners in chief refuse to consider the matter on appeal from the final decision, if they do refuse, and he may then have their decision reviewed by the appellate tribunals, including the Court of Appeals, and may allege as error the failure to give proper weight to the question raised by this motion. If error shall be made by the tribunals of this office, it is to be presumed that the Court of Appeals will set it right. Lowry is surely not warranted in asking this office to set aside

all rules of procedure and permit piecemeal appeals on motion merely because of the fear that the tribunals may overlook or disregard the question at final hearing.

No good reason is seen for changing the provision in Rule 124 here in controversy, which was adopted and approved by a long line of Commissioners of Patents, among whom have been some of the ablest patent lawyers in the country, and which rule has been acquiesced in by patent attorneys practicing before the Office for the last quarter of a century.

It is noted that a petition similar to this one was denied by the assistant commissioner on June 29, 1904, and that this is in effect
44 a request for a reconsideration of the matter.

The petition is denied.

F. I. ALLEN, *Commissioner.*

DECEMBER 6, 1904.

Endorsed: Leave to amend the petition herein in the particulars stated, granted.

HARRY M. CLABAUGH,
Chief Justice Supreme Court, District of Columbia.

Stipulation.

Filed January 3, 1905.

Supreme Court of the District of Columbia.

UNITED STATES EX RELATIONE GEORGE A. Lowry and Planters' Compress Company *vs.* FREDERICK I. ALLEN, COMMISSIONER OF PATENTS, Edward B. Moore, Assistant Commissioner of Patents, S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, board of examiners in chief in the U. S. Patent Office.	No. 47053.	At law.

In view of the fact that the petition in the above-entitled cause has been amended and of the fact that a copy of the amended petition
45 has been served upon the respondent F. I. Allen, Commissioner of Patents, it is stipulated by and between counsel, first, that the failure to serve a copy of the original petition upon the respondent F. I. Allen within the time fixed in the order to show cause is waived; second, that the answer of said F. I. Allen to the order to show cause shall be taken to be the same as the answer of the respondent E. B. Moore; and, third, that the respondents admit the allegations in paragraphs XIa, XIb in the amended petition.

A. V. CUSHMAN,
Attorney for Petitioner.
JOHN M. COIT,
Attorney for Respondents.

Order granting writ of mandamus, &c.

Filed January 14, 1905.

Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA EX RELATIONE GEORGE A. LOWRY AND PLANTERS' COMPRESS COMPANY *vs.* FREDERICK I. ALLEN, COMMISSIONER OF PATENTS, AND S. W. STOCKING, J. H. BRICKENSTEIN, AND THOMAS G. STEWARD, BOARD OF EXAMINERS IN CHIEF IN THE UNITED STATES PATENT OFFICE.	No. 47053.	At law.

46 To the honorable Frederick I. Allen, Commissioner of Patents; Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein, and Thomas G. Steward, board of examiners in chief in the United States Patent Office, greeting:

Whereas one George A. Lowry, assignor to Planters Compress Company, hath heretofore in the United States Patent Office been made by the officials of the United States Patent Office a party to an interference (No. 21,517) declared between a patent (No. 661,475) granted to said Lowry and an application of one William L. Spoon (Serial No. 74,985); and whereas the said Lowry in the United States Patent Office did move to dissolve said interference, in accordance with the law and practice in such cases made and provided; and whereas said motion to dissolve said interference was denied by the primary examiner before whom the motion was made; and whereas said Lowry did then prosecute an appeal from the decision of said primary examiner to the board of examiners in chief in the United States Patent Office, under the provisions of sections 482 and 4909 of the Revised Statutes of the United States; and whereas the said appeal was duly docketed and a day set for hearing before the said board of examiners in chief in the United States Patent Office; and whereas pending said appeal Spoon aforesaid moved to dismiss said appeal, and thereupon, after hearing said motion to dismiss, the said board of examiners in chief did dismiss said appeal, and said appeal now stands dismissed; and whereas said Lowry did thereupon petition the respondent,

Edward B. Moore, Assistant Commissioner of Patents, performing
47 the duties of the office of the Commissioner of Patents as an Acting Commissioner of Patents, to revise and reverse the said decision of the board of examiners in chief dismissing said Lowry's lawful appeal, and to order and direct the said board to entertain said Lowry's appeal and hear and determine the merits thereof according to law; and whereas the said honorable Assistant Commissioner of Patents, after hearing, did refuse the prayer of said petition; and whereas said Lowry did thereupon appeal to the respondent, Frederick I. Allen, Commissioner of Patents, to review, revise, and reverse the said decision of the Assistant Commissioner of Patents and to revise and reverse the said decision of the board of examiners in chief dismissing said Lowry's lawful appeal, and to order and direct the said board to entertain said Lowry's appeal and to

hear and determine the merits thereof according to law; and whereas the said honorable Commissioner of Patents, after hearing, did refuse the prayer of said petition; and whereas said Lowry and said Planters Compress Company did thereafter obtain from this court an order to show cause, addressed to the respondents aforenamed, why a p'remptory writ of mandamus should not issue to compel the respondents to perform their statutory duty to try and determine upon the merits the appeal of said Lowry to the board of examiners in chief in the United States Patent Office; and whereas at a late session of this court, held at Washington, the respondents made return to the said order, setting up that the said Lowry had no right of appeal under the Statutes of the United States, and that a lawfully made rule, No. 124 of the Rules of Practice
48 of the United States Patent Office, denied to a party to an interference the right of appeal from the primary examiner to the board of examiners in chief in an interference case, and setting up also that the decision of the primary examiner appealed from was a decision of a question interlocutory in the interference and not of an appealable nature according to the decision of the Court of Appeals in the District of Columbia, in the case of Westinghouse v. Duncan (66 O. G., 1009), and that in view of all the facts and law above set forth the motion to dismiss Lowry's said appeal had been granted and rightfully granted; and whereas at the same session of this court, upon consideration of the returns of the respondents and of the cause severally shown by them therein against the awarding and issuing of the said writ of mandamus as prayed for by said Lowry and Planters Compress Company, and upon consideration of the arguments of counsel as well on behalf of the several respondents showing cause as aforesaid as on behalf of said petitioners in support of the said rule, it was considered by this court that the several respondents had certified and returned to this court an insufficient cause for having dismissed the said appeal and for having refused to entertain and decide said appeal upon the merits and against the awarding and issuing of the said mandamus pursuant to the rule to show cause aforesaid; and this court, being of this opinion and having determined and adjudged upon the matter aforesaid that the said appeal was lawfully taken and that said rule 124, so far as it denies the right of the petitioner Lowry to appeal from a decision of the primary examiner to the board of examiners in chief, is null and void, as inconsistent with law, it is this 14th day of January, 1905, ordered and adjudged:
49 1st. That the petition of the relators praying that a writ of mandamus issue requiring and commanding you, the said respondent, Frederick I. Allen, Commissioner of Patents, to direct the said board of examiners in chief to cause to be reinstated and to reinstate and take jurisdiction of Lowry's said appeal and to entertain and consider the merits thereof and to decide the same upon the merits thereof, be granted.

2nd. That the rule to show cause be discharged and the petition of the relators be denied as to the respondents Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, G. H. Brickenstein, and Thomas J. Steward, board of examiners in chief in the United States Patent Office.

HARRY M. CLABAUGH,
Chief Justice.

The respondent, Frederick I. Allen, Commissioner of Patents, herein prays an appeal to the Court of Appeals of the District of Columbia from the judgment of this court granting the petition of the relators, and such appeal is hereby allowed.

HARRY M. CLABAUGH,
Chief Justice.

Approved as to form:
JOHN M. COIT,
Attorney for Respondents.

50 *Order for transcript of record.*

Filed January 20, 1905. In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA, EX RELATIONE George A. Lowry and Planters Compress Company,
vs.
FREDERICK I. ALLEN, COMMISSIONER OF PATENTS; Edward B. Moore, Assistant Commissioner of Patents, and S. W. Stocking, J. H. Brickenstein, and T. G. Steward, board of examiners in chief in the United States Patent Office.
No. 47053. At law.

The clerk will please make a transcript in the above-entitled case for use on appeal, including the following papers:

1. Petition for mandamus and attached exhibits, filed July 7, 1904.
2. Return of respondent Edward B. Moore, filed July 14, 1904.
3. Replication and motion for writ, filed July 26, 1904.
4. Amended petition, filed December 29, 1904.
5. Stipulation of counsel, filed January 3, 1905.
6. Final order and appeal, filed January 14, 1905.

JOHN M. COIT,
Attorney for Respondent.

51 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA,
District of Columbia, ss:

I, John R. Young, clerk of the Supreme Court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 50, inclusive, to be a true and correct transcript of the record, as per directions of counsel herein filed, copy of which is made part of this transcript, in cause No. 47053, at law, wherein The United States of America, *ex relatione* George A. Lowry and Planters Compress Company, are relators, and Frederick I. Allen, Commissioner of Patents, et al., are respondents, as the same remains upon the files and of record in said court.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 24th day of February, A. D. 1905.

[SEAL.] JOHN R. YOUNG, *Clerk.*

(Endorsed on cover:) District of Columbia Supreme Court. No. 1521. Frederick I. Allen, Commissioner of Patents, appellant, vs. The United States of America, *ex relatione* George A. Lowry et al. Court of Appeals, District of Columbia. Filed February 24, 1905. Henry W. Hodges, clerk.

O

WEDNESDAY, *April 5th, A. D.* 1905.

FREDERICK I. ALLEN, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES OF AMERICA *ex Relatione* GEORGE A. Lowry and Planters Compress Company. } No. 1521.

The argument in the above entitled cause was commenced by Mr. J. M. Coit, attorney for the appellant, and was continued by Messrs. Oliver Mitchell and Edmund Wetmore, attorneys for the appellees, and was concluded by Mr. J. M. Coit, attorney for the appellant.

On motion, both sides are allowed to file supplemental brief herein if so advised.

FREDERICK I. ALLEN, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES OF AMERICA *ex Relatione* GEORGE A. Lowry and Planters Compress Company. } No. 1521.

Opinion.

(Mr. Justice DUELL delivered the opinion of the court:)

This appeal is taken from a judgment of the supreme court of the District of Columbia, granting the petition of the relators that a mandamus issue commanding the Commissioner of Patents to direct the examiners-in-chief of the Patent Office to reinstate and take jurisdiction of an appeal taken by Lowry from the ruling of the primary examiner denying his motion to dissolve an interference declared by the Patent Office between his unexpired patent and a pending application for patent filed by one William L. Spoon.

The interference was declared under section 4904 of the Revised Statutes.

The record discloses that the interference was declared and notice thereof duly given to the parties as required by law.

In accordance with Patent Office rule 122, which is one of the rules promulgated by the Commissioner of Patents under the authority conferred upon him by section 483 of the Revised Statutes, Lowry moved to dissolve the interference upon the various grounds specified in the rule and that motion was transmitted by the examiner of interferences to the proper principal examiner for a hearing. The reason urged at the hearing by Lowry for the dissolution was that Spoon had no right to make the claims in controversy because his application was for an inoperative device.

The petition sets forth and the answer admits that various proceedings were had in the interference after Lowry's motion to dissolve was transmitted to the principal examiner and before his final refusal to dissolve the interference, which denial led to Lowry's appeal to the examiners-in-chief, which was by them dismissed and

which is required to be reinstated and heard by the mandamus granted by the court below.

It is unnecessary to refer to these various proceedings, for no allegation is made that any of them were irregular or that they were contrary to the statutes and rules governing the conduct of interference proceedings, and therefore, they have no legitimate bearing upon the question raised by the petition for the mandamus.

The facts which raise the question as to the relator's right to the mandamus may be briefly summarized. Lowry having been made a party to an interference, as provided by section 4904, made a motion for its dissolution in accordance with Patent Office rule 122, which motion being denied by the principal examiner, who ruled that Spoon had the right to make the claims, Lowry filed an appeal to the examiners-in-chief, although Patent Office rule 124 expressly provided that no appeal could be taken from a ruling by the examiner that a party to an interference had the right to make the interfering claims. Upon motion duly made Lowry's appeal was dismissed by the examiners-in-chief, and, the Commissioner of Patents having denied Lowry's petition for an order directing the examiners-in-chief to reinstate and determine the appeal, he applied to the supreme court of the District of Columbia for a writ of mandamus, which was granted.

The question which it becomes necessary for us to decide is simply whether the court below erred in issuing the mandamus commanding the Commissioner to direct the examiners-in-chief to reinstate and determine the appeal. It is contended on behalf of the relators that the rule is contrary to law because it deprives a party to an interference of the right to an appeal given him by the statute. If this contention be correct, then the court below rightly granted the mandamus. If not, its grant was an error and must be reversed. The paragraph of rule 124 in question provides that from a decision of the primary examiner, affirming the patentability of the claim or the applicant's right to make the same, no appeal can be taken. No question has or can be raised that the Commissioner of Patents has the right to regulate the conduct of proceedings in the Patent Office, including thereunder interference proceedings, by lawful rules, provided they are approved by the Secretary of the Interior, as the rule in question has been. Sec. 483, U. S. Revised Statutes.

It was incumbent upon Lowry, in order to entitle him to a writ of mandamus, to show that he had a clear right of appeal under the statute relating to appeals in interference cases. *Ex parte* Cutting, 94 U. S. 14.

The sections of the statute and the rules of the Patent Office, which are to be considered in disposing of this appeal, are sections 482, 483, 4904, and 4909, and rules 122 and 124. These read as follows:

"SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and,

when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

"SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

"SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than 20 days, as the Commissioner shall prescribe.

"SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

"122. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which deny the patentability of an applicant's claim, or his right to make the claim, should, if possible, be made not later than the twentieth day after the statements of the parties have been received and approved. Such motions, and all motions of a similar character should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form, the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

"124. Appeal may be taken directly to the Commissioner from decisions on all motions except the following: (1) On motions to dissolve which deny the patentability of applicant's claim; (2) on motions to dissolve which deny the right of an applicant to make the claim; (3) on motions involving the merits of the invention. Decisions on these motions, when appealable, go to the examiners in chief, *in the first instance*, and upon such appeals the questions shall be heard *inter partes*.

"From a decision of the primary examiner affirming the patenta-

bility of the claim or the applicant's right to make the same no appeal can be taken."

It will be helpful in determining the question, to consider the history of the legislation relating to interferences and the rules promulgated from time to time by the Commissioner of Patents. Congress, as early as 1793, recognizing the likelihood of two or more different parties claiming a prior inventorship of the same invention, and the necessity of providing for a determination of such question, made provision therefor, which in some form or other has continued to this day. The patent act of 1793 provided that in case of interfering applications, the same should be submitted to three arbitrators, the decision of a majority of whom should be final as far as related to the grant of a patent. This provision remained in force until the patent act of 1836. This act created the Patent Office and inaugurated the present examination system, based on novelty as well as usefulness. Under the prior acts it may be stated that patents were granted without examination as to novelty, the only questions being considered were usefulness, importance, and the form of the papers. Section 8 of the act of 1836 provided for the determination of questions of priority of invention between interfering applications and between such applications and unexpired patents. Here first appears the provision for bringing unexpired patents into interference proceedings. Of course the patent could not be recalled or revoked should the interference result in an award of priority to the applicant. The patentee could then, as now, bid defiance to the Patent Office. All that could be done was to issue a patent to the applicant, in which event there would be two outstanding patents for the same invention. Section 16 of the act provided a remedy for this, and also further relief for the applicant should his application for a patent be denied by the decision of the board of examiners. Such relief was by bill in equity, which could be filed by either party, whereupon the court could consider the whole matter *de novo*, and declare either or both patents void in whole or in part, or, where one party was an applicant, could award a patent to him. In other words, interference proceedings in the Patent Office were not final under the act of 1836, nor have they since been, for similar provisions are found in the later statutes on the subject and are now set forth in sections 4915 and 4918 of the Revised Statutes. Under the act of 1836 the Commissioner was directed to give notice to the parties, and, if either was dissatisfied with his decision on the question of priority made after hearing, an appeal could be taken to a board of three disinterested persons appointed by the Secretary of State, and the decision of a majority was binding upon the Commissioner of Patents. By the patent act of 1839 this board was abolished and its powers were vested in the chief justice of the district court of the United States for the District of Columbia. The act of 1852 extended a like authority to the assistant judges of the circuit court of said District. The next change in procedure occurred when the patent act of March 2, 1861, went into effect. Section 2 of this act provided for the appointment of three examiners-in-chief, whose duty as to appeals in interference proceedings will

later be set forth. From their decisions appeals were provided to the Commissioner of Patents. At this time there was no such officer as an examiner of interferences and the control of interferences was in the hands of the various primary examiners. Their decisions in both *ex parte* and interference cases were appealable successively to the examiners-in-chief, the Commissioner of Patents, and to any one of the justices of the circuit court. The next change occurred when the act known as the "Consolidated patent act," approved July, 1870, went into effect. This act provided for the appointment of a special examiner of interferences to decide the question of priority in the first instance, and whose decisions were appealable successively to the examiners-in-chief and to the Commissioner, whose decision was final and so remained until the Court of Appeals of the District of Columbia was established in 1893. Section 42 of the act of 1870 contains the provision for interferences. The act of 1870 was repealed by the Revised Statutes of 1874, but section 42 of the earlier act was continued in the same terms as section 4904 of the Revised Statutes, which provides for the decision of the question of priority.

From the foregoing it is apparent that interferences were instituted for the purpose of deciding the question of priority of invention, and for no other purpose, and it logically follows that the reviews or appeals provided were to be from the decisions awarding priority by the officer who was authorized to decide the question of priority in the first instance. For example, the act of 1836 in providing for appeals expressly says that the appeal is one from the decision on the question of priority. The act of 1861 providing for the appointment of examiners-in-chief does not in words specify what the appeals in interference cases are to embrace, but manifestly they could only relate to the question of priority, as that was the only question for the determination of which the interference was instituted. When they came to pass upon the question of priority they doubtless might pass upon such matters as were essential to the correct determination of that question. Neither the statute creating the board of examiners-in-chief, nor any other, provides for motions to dissolve an interference for any reason after it was once declared, and not providing for such motions they do not provide for any appeals therefrom. In fact, motions to dissolve are not the creature of any statute, but are the rules of the Patent Office, and no provision, by Patent Office rules, for such motions were made until many years after the statutes relating to interferences were enacted. Section 42 of the act of 1870, re-enacted in 1874 and now in force and known as section 4904 of the Revised Statutes, in line with the earlier statutes, provides for the institution of interferences for the sole purpose of determining the question of priority of invention, and the fair intendment of section 4909, which provides for appeals in interference cases, is that such appeals only go to the question of priority of invention, for the determination of which they are instituted.

We can not emphasize too strongly that, in our opinion, the statutes relating to interferences only provide that they shall be instituted for the sole purpose of determining priority of invention,

and that it logically follows that appeals in such proceedings, so far as the statutes go, only provide for appeals from the decisions of priority. The Commissioner of Patents, under the authority given to regulate the proceedings in the Patent Office, is clothed with power to regulate all interlocutory proceedings in interference cases by rules not inconsistent with law. If he deems it wise to provide, after the interference has once been declared, for remanding the interference to the primary examiner for the purpose of an interlocutory hearing and determination of a motion to dissolve it for any reason which he considers may be in the interest of the public or the parties, we take it that he has full power to do so, and that he may also provide that such motions may or may not in some or all respects be reviewed by the appellate tribunals of the Patent Office, and in so doing he is not thereby depriving any party of any statutory right to have all questions passed upon at final hearing, and on appeals therefrom, which are necessary for a correct determination of the question of priority, which is the sole question for which interferences are declared. If we find that at the time of the enactment of section 4909 there was no provision either in the statutes or the rules of the Patent Office for any such proceeding as a motion to dissolve, we fail to see how it can be assumed that Congress meant to provide for an appeal from the denial of a motion of so plainly an interlocutory character. It would be putting a forced construction upon the statute to so hold. If it be assumed that there is a legal right in a party to an interference, after it is once declared, to make an interlocutory motion for its dissolution before the final hearing on the question of priority, irrespective of any statute or rule, we fail to comprehend upon what principle it can be successfully contended that the right of an appeal to a higher tribunal lies, in the absence of express grant of such an appeal. It is on interlocutory matter, and at best brings up only partly and indirectly the question of priority, and if successive appeals be permitted the result would be only to add another terror to the many surrounding an interference proceeding in the Patent Office. From the simple and summary mode first adopted for determining the question of priority of invention that proceeding, by system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who becomes involved therein is a second Sinbad the sailor. It is known to all who are familiar with the practice in interference proceedings that by motions, petitions, and appeals of every conceivable character that the ingenuity of the skilled attorney can devise, interferences can be and are prolonged for years, to the injury of the public, and often to the financial ruin of the parties. It does not appear when the present interference was declared, but in view of all the proceedings had, as disclosed by the record, it has been a long time and no testimony has yet been taken. Should we affirm the decision of the court below, the reasons for which are not set forth, and reverse the practice of the Patent Office as it has stood unchanged for at least twenty-five years, we would be placing still another burden of successive piecemeal appeals upon the unfortunate interferant in a pro-

ceeding which, when decided, is not final, for, as we have shown, when the defeated party is an applicant he can, if defeated in the Patent Office, proceed by bill in equity under section 4915 of the Revised Statutes to obtain a patent, and if one be finally awarded him he can again try the question of priority with his former successful antagonist under section 4918 of the Revised Statutes. In the present case, as we have shown, should a patent be awarded to Spoon, the question of priority could be at once retried by Lowry, or by Spoon, under the latter section. We refer to this feature of the case with full knowledge that the motives of a party in asserting a legal right can not deprive him of it, and without in the remotest manner intending to question the good faith of Lowry, but because the question is so important to the rights of the public and of inventors, which are best subserved by a speedy grant of lawful patents to rightful parties, and with the least possible expense. We should not, however, in the light of what is really accomplished through an interference, go out of our way, or unduly search for some plausible ground on which to predicate a finding that Lowry has a clear right of appeal from an examiner's decision in an interlocutory proceeding. Such rulings, as we have said, are not appealable prior to final judgment or decree unless it be so provided by statute. Ency. of Pl. and Pr., vol. 2, page 81.

We have stated in general terms that we find nothing in the statutes permitting an appeal in such interlocutory motions, but before referring more particularly to the statutes in question it will be well to examine the history of interlocutory motions to dissolve interferences, provision for which has from time to time been made by the rules of the Patent Office. The first provision in the rules relating to their dissolution because improperly declared is found in rule 58 of August 1, 1869, eight years after the creation of the board of examiners-in-chief. This rule says:

"58. Cases of interferences will, when the issue is made up and the testimony taken, be tried before an examiner specially detailed for that purpose. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties."

It will be seen that this does not, except by interference, provide for a dissolution of an interference, and no ground is stated upon which a motion may be based, save the general one that it has been improperly declared, and no provision of any kind is made for an appeal from any order made after the decision of the motion.

The act of 1870 having provided for an examiner of interferences, provision was made in rule 59, of July 15, 1870, for their trial before such officer. Its full provisions are as follows:

"59. Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned,

or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists."

The last paragraph of this rule, as amended in 1871, contains the first express provision for an interlocutory motion for dissolution of an interference. It says:

"A motion for a dissolution of an interference on the ground that it was improperly declared, if made before the taking of testimony, will be heard by the primary examiner who declared the interference."

On September 1, 1873, the following clause was added to the rule:

"Upon such hearing the primary examiner will recommend the granting or refusal of such motion, and the examiner in charge of interferences will order accordingly."

The rule was changed April 1, 1875, so as to read as follows:

"59. An interference will not be declared until the subject-matter involved is decided to be patentable. If after being declared it is found that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, it will be dissolved, and an appeal may be taken to the Commissioner in person."

It will be seen that here first is made any provision for an appeal from the decision of the interlocutory proceeding and such appeal was allowed to the Commissioner in person.

November 1, 1876, the phraseology of this rule was changed in matters not material to the question under consideration and the following clause added to it: "But if the examiner should decide that the subject-matter is not patentable in view of the state of the art the interference will be dissolved and the matter decided upon can be proceeded with *ex parte*." Without material modification this rule remained in force until the general revision of rules of December 1, 1879, when the following rules relating to dissolution were adopted:

"116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in rules 97, 101, and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless revised or modified on appeal. From a decision of the primary examiner on such motion, denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken *ex parte* to the examiners-in-chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken.

"117. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregu-

larity in declaring the same as will preclude the proper determination of the question of priority between the parties, and all other lawful motions except those mentioned in rule 116, will be made before the tribunal having jurisdiction at the time. * * *

"118. Appeal may be taken directly to the Commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant's claims or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners-in-chief (see rules 116, 141)."

Here first appears provision for an interlocutory motion to dissolve an interference upon the ground that a party to it has not the right to make the interfering claim, which was the ground urged by Lowry upon the hearing of his motion. The provisions for appeals are found in rules 116 and 118, which provide an appeal to the examiners-in-chief from (among other decisions) one *denying* the right of an applicant to make the interfering claim. No provision is made for an appeal from a decision *affirming* his right to make the interfering claim. September 15, 1880, the following clause was added to rule 118, and it has been ever since in force. It reads, "from a decision affirming the patentability of the claim, or the applicant's right to make the same, no appeal can be taken." This clause simply makes clear and positive the then well-settled rule of the office that no appeal was permitted in any proceeding where the examiner held that a claim was patentable to the party making it. The Commissioner, however, was of course not debarred from exercising his supervisory power and for lawful reasons reversing the holding of the examiner and refusing to allow the claim. From that time on changes have been made in the rules relating to the conduct of interferences until the rules have the phraseology shown in present rules 122 and 124. It will be seen that at no time has an appeal been provided from a decision rendered on hearing an interlocutory motion for a dissolution of an interference affirming the right of a party to make the interfering claim.

It is urged on behalf of appellees that rule 55 of July 15, 1870, and rule 55 of 1871 (the latter when read in the light of rule 48 of the same date), provided for appeals to the examiners-in-chief from decisions on interlocutory motions for the dissolution of interferences. These rules are as follows:

"55. In cases of interference, parties have the same remedy by appeal as other applicants, to the examiners-in-chief and to the Commissioner, but no appeal lies in such cases from the decision of the Commissioner. Appeals in interference cases should be accompanied by a brief statement of the reasons thereof.

"55. In cases of interference appeals may be taken to the examiners-in-chief and to the Commissioner in the manner provided in rule 48.

"48. In cases of interference parties have the same remedy by appeal to the examiners-in-chief and to the Commissioner, as in *ex parte* cases, but no appeal lies in such cases from the decision of the Commissioner." * * *

We do not so read them, because at the time of their promulgation there were in force no rules providing for such motions, and, secondly, because the statute of 1870 relating to appeals provides that the appeals in interference were only from final decisions awarding priority.

Nor, as we have said, can authority for appeals in such matters to the examiners-in-chief be predicated upon the clause of rule 59 of 1875. The 1877 rule 59 is, in respect to appeals, very similar to that of 1875, but counsel for appellees seem to have overlooked that rule and considered rule 59 of 1877 as a new rule. They have not quite correctly quoted rule 59 of 1877. But both rules give the right of appeal, not to the examiners-in-chief, but to the Commissioner, and it will be remembered that at this date no provision was made in the rules for interlocutory motions to dissolve interferences on the ground that a party to it had not the right to make the interfering claim.

While we recognize the rule, as laid down in Houghton *v.* Payne, 194 U. S. 88, and in other decisions of the Supreme Court, that if a practice is contrary to law it is not made lawful by the practice of a department for a long period of time, yet due regard should be given to a practice which admittedly has prevailed for more than twenty-five years in proceedings of a judicial character, even should there be a reasonable doubt in the mind of the court as to the proper construction to be placed upon a statute. The Supreme Court said in Bate Refrigerating Co. *v.* Sulzberger, 157 U. S. 1:

"* * * If the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject, if there be reasonable ground for adopting one of two constructions; this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government."

With such light as is afforded from a consideration of prior statutes and the rules made by the Commissioner of Patents under statutory authority, we will more fully consider section 4909, which is the same as section 46 of the act of July 8, 1870. Provision was first made for a board of examiners-in-chief by section 2 of the act of March 2, 1861. That section provided that the duty of the board was "on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases," etc. Manifestly, the appellate power to revise the decision of examiners in interference cases referred to such decisions as examiners then had the power to make in such proceedings, and we are not referred to any statute or Patent Office rule, nor have we been able to discover any such statute or rule, which gave to the examiners any question for them to decide but that of priority. There was at that time no statutory authority lodged in examiners to decide interference cases, but as the business of the Patent Office increased it became necessary for

the Commissioner of Patents to delegate more and more of his duties to his assistants, but no statutory authority is shown to have been given to the Commissioner at this time to decide more than the question of priority of invention. Undoubtedly it was within his power and his duty in deciding that question to examine and decide all ancillary matters necessary to the correct determination of the main question, and when he delegated his authority in interference cases, so far as he could, to his assistants, it is fair to presume that such ancillary questions, if necessary to the decision of the question of priority, could be examined and decided by them. But it by no means follows that such ancillary questions were to be decided by him, or them, in advance of the decision of the main question—that of priority. Therefore we conclude that when an appeal was given to the examiners-in-chief to review the decisions of examiners in interference cases, Congress had not in mind to confer power of review upon them except as to the question of priority, and such ancillary questions as the examiners had passed upon when deciding the question of priority for which the interference was instituted. When section 46 of the act of 1870 was written there had been created an examiner of interferences, who took the place of the examiners in deciding the only question for which an interference is instituted. Therefore we find provision made for appeals from his decisions, and this was carried forward in section 4909 of the revision. For convenience, we again set forth this section:

"SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief, having once paid the fee for such appeal."

In the light of the previous statutes we think that the proper construction to be placed on this section is as though it read, every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner, and every party to an interference may appeal from the decision of the examiner in charge of interferences in such case, to the board of examiners-in-chief. In other words, to abbreviate and make the section more succinct the words "may appeal from the decision" were used but once, but we think that thereby clearness was sacrificed for brevity. We are also of the opinion that the decisions relating to interferences, referred to in sections 482, 4904, and 4909 of the Revised Statutes, from which appeals are allowed to the examiners-in-chief and from them to the Commissioner of Patents, are final decisions and are not such as are made in interlocutory matters which do not of themselves preclude and prevent a decision of the question of priority, which is, as we have said, the purpose for which interferences are instituted.

The act of 1893 which created this court provides that "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals." We have construed that clause to refer only to final decisions by the

Commissioner in interference cases, and have refused to take jurisdiction and decide interlocutory questions sought to be brought before us on appeal in advance of an appeal taken in such cases to review a final decision awarding priority of invention. As we said in Westinghouse *v.* Duncan, 2 App. D. C. 131, in referring to appeals allowed by the statute, "the terms of the statute should receive a reasonable interpretation and be so construed as to avoid multiplying litigation or producing unnecessary delay and expense to the parties concerned, and to prevent, as far as possible, embarrassment and hindrance to the proceedings in the Patent Office." We think this reasoning applies equally to appeals in the Patent Office in interlocutory proceedings in interferences. There should be some limit on appeals, for where three millions of dollars have been invested, as stated in this case, by the party holding the patent, there is every incentive to prolong the proceedings until the expiration of the patent, and if then the applicant is successful it means a second patent for 17 years, and the public, instead of paying tribute for 17 years, will have had a patent monopoly existing for twice that period, or for a goodly portion of it.

The power to decide the question of priority, which is the sole question for which interferences were provided, as shown by a reading of every statute on the subject enacted from 1793 down to the present time, having been transferred from the examiners generally to the particular examiner designated as the examiner of interferences, it became necessary to transfer this right of appeal in interferences from the decisions of such examiners to the examiner of interferences. It was not, as an examination of the rules of the Patent Office has shown, until 1871 that any provision was made for the dissolution of an interference before testimony had been taken and before a decision on the question of priority was in order. Whether in the light of experience it has proven to have been in the interest of interferants and of the public, to provide the elaborate system of preliminary or interlocutory motions to dissolve interferences, which has been the outgrowth of the power lodged in the Commissioner under section 483, is perhaps a debatable question. However that may be, we think it clearly within his power in making provision for these interlocutory motions to limit the right of appeal where, as in the present case, the examiner has held that the applicant had the right to make the claims of the interference. Whatever right the relators may have to the judgment of the appellate tribunals of the Patent Office and of this court upon the question of an absence of right in Spoon to make the interfering claims because his device is inoperative, we think that right is not through an appeal from the refusal of the examiner to dissolve an interference upon the hearing of an interlocutory motion made for that purpose, where no right of appeal is granted by the rule under which the motion is made. We take it that the Commissioner could abrogate both rules 122 and 124 without depriving parties to an interference of any statutory right. If he has the right to make rules for interlocutory motions, he certainly has the right to repeal them.

The right of a party to make the claim of an interference is not

finally determined by the decision of the examiner on a motion for a dissolution. This is clearly shown by rule 126 of the Patent Office under which the examiner of interferences or the examiners-in-chief before or on deciding the question of priority are authorized to call the attention of the Commissioner to the fact that no interference exists, or that there is a statutory bar to the grant of a patent, etc., whereupon the interference may be remanded to the primary examiner for examination and decision. Appeals are allowed from his decision as in other cases. It is not necessary in this proceeding to construe this rule or to pass upon the question whether the lack of a right of party to an interference to make a claim by reason of the inoperativeness of the invention disclosed in his application, does or does not relate to the question of priority as referred to in said rule. However this may be, it would seem that it might in many cases be quite difficult to decide the question of priority where the evidence showed that the device disclosed in the application was not operative. It will be time, however, to decide that question when it is presented in a case where we are called upon to decide the question of priority. We have, however, reviewed other ancillary questions when they have properly come before us on appeals from final judgments awarding priority of invention. Stevens *v.* Seher, 11 App. D. C. 245. We have declined to entertain appeals from decisions of the Patent Office that were not final decisions.

We are clearly of the opinion that the court below erred in granting the petition for the writ of mandamus. Our reasons, summarized, are these: That a motion to dissolve an interference before the final hearing of the question of priority, and before the case is ready for such hearing, is an interlocutory proceeding and is not appealable unless made so by statute or rule of court; that no statute, and, more specifically stated, neither sections 482, 4904, or 4909 of the Revised Statutes, nor any rule of the Patent Office made by the Commissioner, gives the right of appeal to the examiners-in-chief from decisions made by the principal examiners on the hearing of a motion to dissolve, holding that a party has the right to make the claim which is the issue of an interference; that where the statute gives the right of appeal in interferences from decisions of any officer of original jurisdiction it means final decisions; that the right to such an appeal should be clear, and that if there is any doubt, although we believe there be none, as to the construction of the statutes claimed to confer the right, such doubt should be resolved in favor of the long established and acquiesced-in practice of the Patent Office, which we believe is in the interest of interferants; that the provision for interlocutory motions to dissolve interferences is the creature of a rule and not founded on statutory enactment and that a party to an interference is not deprived of any statutory right to an appeal by reason of the rules not providing for an appeal from a decision of the examiner that a party has a right to make the interfering claim; that whatever right a party to an interference has to contest the right of his adversary to make the interfering claim, such right if denied is reviewable, if at all, upon the final

decision of the question of priority, and such right of appeal as he has to have that question decided is to be considered on the hearing of the statutory appeals allowed from the decision of the question of priority by the examiner of interferences.

The relators not having shown that they have a clear right of appeal which has been denied are not entitled to the writ of mandamus and therefore the court below erred in granting the order of January 14, 1905, awarding a writ of mandamus directing the Commissioner of Patents to direct the examiners-in-chief to reinstate and take jurisdiction of Lowry's appeal and to entertain and consider the merits thereof and to decide the same upon the merits. It follows that the order granting the writ of mandamus should be reversed, with costs, with directions to discharge the rule to show cause and to dismiss the petition. It is so ordered.

Reversed.

WEDNESDAY, *May 24th, A. D.* 1905.

FREDERICK I. ALLEN, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES OF AMERICA *ex Relatione* George A. Lowry and Planters Compress Company.
No. 1521, April Term, 1905.

Appeal from the Supreme Court of the District of Columbia.

This cause came on to be heard on the transcript of the record from the supreme court of the District of Columbia, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the order of the said supreme court, in this cause, be, and the same is hereby, reversed with costs; and that this cause be and the same is hereby remanded to the said supreme court with directions to discharge the rule to show cause and to dismiss the petition.

Per MR. JUSTICE DUELL.

May 23, 1905.

TUESDAY, *June 6th, A. D.* 1905.

FREDERICK I. ALLEN, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES OF AMERICA *ex Relatione* GEORGE A. Lowry and Planters Compress Company.
No. 1521.

On motion of Mr. A. V. Cushman, of counsel for the appellees, it is ordered by the court that a writ of error to remove this cause to the Supreme Court of the United States issue, and the bond for costs is fixed at the sum of $300.

FREDERICK I. ALLEN, Commissioner of Patents, Appellant,
vs.
THE UNITED STATES OF AMERICA *ex Relatione* GEORGE A. Lowry and Planters Compress Company.
No. 1521.

It is ordered by the court that the mandate in the above entitled cause be stayed until further order of the court.

UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the justices of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before you, or some of you, between Frederick I. Allen, Commissioner of Patents, appellant, and The United States of America *ex relatione*, George A. Lowry and Planters Compress Company, appellees, a manifest error hath happened, to the great damage of the said appellees as by their complaint appears. We being willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington, within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 6th day of June, in the year of our Lord one thousand nine hundred and five.

[Seal Court of Appeals, District of Columbia.]

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

Allowed by—
——.

Bond on Writ of Error.

Know all men by these presents, that we, George A. Lowry, and Planters Compress Company, as principals, and American Bonding Company of Baltimore, as surety, are held and firmly bound unto Frederick I. Allen, Commissioner of Patents, in the full and just sum of three hundred dollars ($300.) to be paid to the said Frederick I. Allen, Commissioner of Patents, his certain attorney, executors,

administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this 13th day of June, in the year of our Lord one thousand nine hundred and five.

Whereas, lately at a Court of Appeals of the District of Columbia, in a suit depending in said court, between United States *ex relatione* George A. Lowry and Planters Compress Company *vs.* Frederick I. Allen, Commissioner of Patents a judgment was rendered against the said George A. Lowry and Planters Compress Company, and the said George A. Lowry, and Planters Compress Company having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Frederick I. Allen, Commissioner of Patents citing and admonishing him to be and appear at a Supreme Court of the United States, to be holden at Washington, within thirty days from the date thereof:

Now, the condition of the above obligation is such, that if the said George A. Lowry and Planters Compress Company shall prosecute said writ of error to effect, and answer all damages and costs if they fail to make their plea good, then the above obligation to be void; else to remain in full force and virtue.

PLANTERS COMPRESS COMPANY,
By FREDERIC S. GOODWIN, *Secretary.*

[Seal of Planters Compress Company.]

AMERICAN BONDING COMPANY
OF BALTIMORE,
By THOS. J. DE LASHMOTT,
Attorney in Fact.

[Seal of American Bonding Company of Baltimore.]

Sealed and delivered in the presence of—

—— ——.

Approved—

JOHN M. COIT,
Counsel for Com'r Pats.

Approved by—

SETH SHEPARD,
Chief Justice Court of Appeals
of the District of Columbia.

[Endorsed:] No. 1521. Frederick I. Allen, Commissioner of Patents, appellant, *vs.* The United States of America *ex relatione*, George A. Lowry and Planters Compress Company. Bond on writ of error to Supreme Court U. S. Court of Appeals, District of Columbia. Filed June 14, 1905. Henry W. Hodges, clerk.

UNITED STATES OF AMERICA, *ss:*

To Frederick I. Allen, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein The United States of America *ex relatione*, George A. Lowry and Planters Compress Company are plaintiffs in error, and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiffs in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Seth Shepard, Chief Justice of the Court of Appeals of the District of Columbia, this 14th day of June, in the year of our Lord one thousand nine hundred and five.

SETH SHEPARD,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted June 14, 1905.

JOHN M. COIT,
Counsel for Defendant in Error.

[Endorsed:] Court of Appeals, District of Columbia. Filed Jun. 14 1905 Henry W. Hodges, clerk.

Court of Appeals of the District of Columbia.

I, Henry W. Hodges, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 38, inclusive, contain a true copy of the transcript of record and proceedings of said Court of Appeals in the case of Frederick I. Allen, Commissioner of Patents, appellant, *vs.* The United States of America *ex relatione* George A. Lowry and Planters Compress Company, No. 1521, April term, 1905, as the same remain upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 16th day of June, A. D. 1905.

HENRY W. HODGES,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: File No. 19,813. District of Columbia Court of Appeals. Term No. 311. The United States *ex rel.* George A. Lowry and Planters Compress Company, plaintiffs in error, *vs.* Frederick I. Allen, Commissioner of Patents. Filed June 23d, 1905. File No. 19,813.

FILE COPY.

Supreme Court of the United States

OCTOBER TERM, 1906.

Office Supreme Court U. S.
FILED
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JAMES H. McKENNEY,
Clerk

Docket No. 56.

THE UNITED STATES ex Relatione GEORGE A. LOWRY and PLANTERS COMPRESS COMPANY.
Plaintiffs in Error.

vs.

FREDERICK I. ALLEN, Commissioner of Patents.
Defendant in Error.

In Error to the Court of Appeals of the District of Columbia.

BRIEF FOR THE PLAINTIFFS IN ERROR.

Oliver Mitchell,
Edmund Wetmore,
Of Counsel.

Printed by Library Bureau, Boston

Supreme Court of the United States

OCTOBER TERM, 1906.

Docket No. 56.

THE UNITED STATES ex Relatione GEORGE A. LOWRY and PLANTERS COMPRESS COMPANY
Plaintiffs in Error.

vs.

FREDERICK I. ALLEN, Commissioner of Patents.

In Error to the Court of Appeals of the District of Columbia.

BRIEF FOR THE PLAINTIFFS IN ERROR.

The Case Stated.

This case comes to this court upon writ of error to the Court of Appeals of the District of Columbia.

The Petition (Record, p. 2) shows that this case arises out of an interference in the United States Patent Office between an application of William L. Spoon for a patent for a Cotton Bale, filed Sept. 10, 1901, and the Letters Patent of George A. Lowry (assignor to the Planters Compress Company) for a Cotton Bale, dated Nov. 6, 1900, and filed Jan. 29, 1897.

The Lowry-Spoon interference was declared in the United States Patent Office at the request of Spoon

and the petitioner Lowry was, by the authorities of the Patent Office, made a party to the interference.

Lowry moved to dissolve the interference upon the several grounds mentioned in Rule 122 of the Rules of Practice in the Patent Office (Record, p. 2; IV; p. 12, 4), which are as follows:—*

(a) That no interference in fact exists;

(b) That there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority;

(c) That the applicant's claim is unpatentable;

(d) That the applicant has no right to make the claim.

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*"122. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which deny the patentability of an applicant's claim, or his right to make the claim, should, if possible, be made not later than the twentieth day after the statements of the parties have been received and approved Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the Primary Examiner, and such motion to transmit should be noticed for hearing upon a day certain before the Examiner of Interferences. When in proper form the motion presented will be transmitted by the Examiner of Interferences, with the files and papers, to the proper Primary Examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the Primary Examiner, if no appeal has been taken therefrom, at the expiration of the time limited for appeal the Examiner will return the files and papers, with his decision, to the Examiner of Interferences. Such decision will be binding on the Examiner of Interferences unless reversed or modified on appeal. (Rule 124.)"

Upon the hearing of the Motion to Dissolve, the Motion to Dissolve was allowed by Primary Examiner Macauley and thereupon the applicant Spoon appealed to the Board of Examiners-in-Chief, who affirmed the decision of the Primary Examiner dissolving the interefence, from which affirmance, Spoon appealed to the Commissioner of Patents in person (Record, p. 2; IV; p. 12, 4), and pending this appeal petitioned the Commissioner to remand the interference to the Primary Examiner to consider the question of operativeness of the Spoon press to make the issue bale and to receive affidavits in support of Spoon's contention as to operativeness. The petition was granted and after a hearing by Acting Examiner Ruckman, the Acting Examiner decided that the Motion to Dissolve should **not** be allowed. Lowry then appealed to the Board of Examiners-in-Chief, his appeal fee was accepted by the Patent Office and his appeal was docketed by the Board and a day set for the hearing, and, before the hearing, Spoon moved to dismiss the appeal of Lowry and upon hearing, Spoon's motion to dismiss the appeal was allowed, upon the ground that the appeal was forbidden by Rule 124 of the Rules of Practice of the Patent Office (Record, p. 9).

Rule 124 is as follows (Record, p. 6):

> "Appeal may be taken directly to the Commissioner from decisions of the Primary Examiner on all motions except the following: (1) On motions to dissolve which deny the patentability of applicant's claim; (2) On motions to dissolve which deny the right of an applicant to make the claim; (3) On motions involving the merits of the invention. Decisions on these motions, when appealable, go to the Examiners-in-Chief, in the first instance, and upon such appeals, the question shall be heard **inter partes.**

> From a decision of the Primary Examiner affirming the patentability of the claim or the applicant's right to make the same no appeal can be taken."

In order to exhaust his remedies in the Patent Office, Lowry thereupon appealed to the Commissioner of Patents to direct the Board of Examiners-in-Chief to entertain and decide his appeal. After hearing before Mr. Assistant Commissioner Moore, this was denied (Record, p. 10). Lowry then brought the matter to the attention of the Commissioner in person and filed a brief in support thereof. December 6, 1904, the Commissioner denied the appeal (Record, p. 19).

Thereupon Lowry and the Planters Compress Company filed their petition in the Supreme Court of the District of Columbia for a writ of madamus (Record, p. 1). After hearing that Court, January 1, 1904, ordered that the writ issue against the Hon. Commissioner, as prayed (Record, p. 22). The Commissioner then appealed to the Court of Appeals of the District of Columbia and upon this appeal the order of the Supreme Court of the District of Columbia was reversed. From that decision the plaintiffs in error prosecute this writ of error.

The validity of Rule 124 of the Rules of practice in the United States patent Office and the action of the officials of the Patent Office under the alleged authority of that rule is challenged by the relator, and the case is therefore one "in which is drawn in question" directly, an "authority exercised under the United States," and the "validity" of such authority. 27 Stat. 436.

Steinmetz v. Allen, 192 U. S. 565.

Houghton v. Payne, 194, U. S. 88.

The following errors are assigned:

First. The Court erred in reversing the judgment of the Supreme Court of the District of Columbia granting the relator's petition for a writ of mandamus.

Second. The Court erred in not affirming the judgment of the Supreme Court of the District of Columbia sustaining the relator's petition for a writ of mandamus notwithstanding the defendant's return.

Third. The Court erred in holding that the sole question authorized to be decided in interference proceedings is the question of priority of invention.

Fourth. The Court erred in holding that the sole question for adjudication in an interference proceeding between applicant and patentee is the question of priority of invention and in not holding that all matters going to the applicant's right to a patent, properly raised in an interference proceeding must be adjudicated.

Fifth. The Court erred in not holding that in the absence of any Rule of Practice established by the Commissioner of Patents regulating the time for taking or hearing such appeal, a decision of a motion to dissolve the interference on the ground that no interference in fact exists, and on the ground that there has been such irregularity in declaring the same as will preclude a proper determination of a question of priority, and on the ground that the applicant's claim is unpatentable, and on the ground that the applicant has no right to make the claim, is immediately appealable under Sec. 4909 of the Revised Statutes of the United States.

Sixth. The Court erred in not holding that Lowry had a Statutory right of appeal to the Board of Examiners-in-Chief from the decision of the Primary Examiner complained of, under Sec. 4909 of the revised Statutes of the United States.

Seventh. The Court erred in not holding that the Board of Examiners-in-Chief had jurisdiction under Sec. 482 of the Revised Statutes of the United States to entertain the relator's appeal and a statutory duty to do so, notwithstanding Rule 124 of the Rules of Practice in the Patent Office.

Eighth. The Court erred in not holding Rule 124 of the Rules of Practice in the United States Patent Office invalid as inconsistent with law and in not holding that, under Sec. 4909, R. S. U. S., Lowry had a right of appeal notwithstanding Rule 124.

Ninth. The Court erred in not holding Rule 124 of the Rules of Practice in the United States Patent Office, void as inconsistent with Sec. 4909 R. S. U. S., and in not holding that the making of Rule 124 of the Rules of Practice in the United States Patent Office, was not a valid exercise of an authority under the United States.

Tenth. The Court erred in treating Sec. 4909 of the Revised Statutes of the United States as so ambiguous as to warrant the application of extrinsic evidence of the intention of Congress in enacting the same.

The plaintiff in error prays that the judgment of said Court be reversed.

THE ISSUE RAISED.

The question raised upon this proceeding is, whether, upon the facts of record, which are admitted

by the return (Record, p. 12) to be true, the Commissioner of Patents should have directed the Board of Examiners-in-Chief to entertain the appeal of Lowry from the decision of the Primary Examiner, notwithstanding Rule 124, since if he should have done so the order of the Supreme Court of the District of Columbia for a writ of mandamus was proper and should have been affirmed, and if he should not have done so the order of the Supreme Court of the District of Columbia for a writ of mandamus was improper and the Court of Appeals properly reversed the lower Court.

Whether the Commissioner of Patents should or should not have ordered the Board of Examiners-in-Chief to entertain the appeal of Lowry, depends upon the true meaning of Secs. 482 and 4909 of the Revised Statutes of the United States, which sections are as follows:

> Sec. 482. The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of Examiners upon applications for patents and for reissues of patents, and in interference cases; and when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he shall assign to them.
>
> Sec. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the Primary Examiner, or of the Examiners-in-Chief, in charge of interferences in such case, to the Board of Examiners-in-Chief, having once paid the fee for such appeal.

PLAINTIFF'S CONTENTION.

An interference is a proceeding of a judicial character instituted by the Commissioner of Patents between rival applicants for a patent for the same invention, to determine which of the applicants is the prior inventor, the determination of this question of fact being entrusted to a Primary Examiner in charge of Interferences with an appeal from said Primary Examiner to the Board of Examiners-in-Chief, to the Commissioner of Patents and to the Court of Appeals of the District of Columbia.

Under the practice of the Patent Office (Rule 122), certain questions arising in interferences, such, for example, as a denial of the right of one of the parties to make the claim, upon the ground that he has shown no operative means to embody the inventional idea, or that there is no interference in fact, because properly read, the rival specifications do not describe the same invention, are referred for determination to that one of the Primary Examiners in whose division the interference arose. These questions, and others of the same character, are raised by a Motion to Dissolve the interference.

In ~~nearly~~ every interference case these two classes of questions present themselves, and when they arise, it is not until they have been determined that the question arises, which party **first** made the invention?

It is obvious that these prior questions are **fundamental** in the case, for if there is no real interference, when the rival specifications are properly read, or if one or both of the parties has not completed any invention whatever by the production of an operative means, it is clear that the question which of the two parties is prior in date, is of no interest. The interference

would fall upon a decision that the parties did not describe in their specifications the same invention, or a decision that one or both of the parties had not produced an operative device.

These questions are no less important and absolutely controlling than is the question of dates.

Palmer v. Lozier, 90 Fed. 732. (C. C. A. 8th, 1898.)

> "In a suit in equity under the Revised Statutes §4918 to obtain an adjudication between interfering patents, the Court is not limited to a determination of the question of priority of invention between the interfering patentees. The statutes necessarily presuppose a patentable invention as the subject matter of the litigation and if it should appear that neither of the patents in suit is valid, for want of such patentable invention, the Court is not required to perform the useless task of considering and adjudicating priorities between them, but should dismiss the bill and deny relief to either party."

Podlesak v. McInnerney, 120 O. G. 2127. (C. A. D. C. 1906.)

> "The question of the right of a party to make a claim goes to the **very foundation** of an interference, for if the party has not such right, the interference falls. If it be incorrectly held that such party has a right to make the claim, priority may be awarded to him and his adversary deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the Primary Examiner who originally declared the interference."

It is utterly immaterial what the truth may be as to alleged dates of invention if one of the contestants

has in fact made no invention at all or the rival inventions are not the same invention.

These "foundation" questions being raised by one of the parties, by a motion to dissolve the interference, a decision of this motion by the Primary Examiner upon the ground that the rival specifications do not describe the same invention, is appealable for both parties, under Rule 124, to the Commissioner. A decision granting the motion to dissolve the interference, for the reason that the other party does **not** show operative means and has therefore completed no invention, gives a right of appeal, under Rule 124, to the Board of Examiners-in-Chief. A decision denying the motion upon the ground that the other party's specification **does** show an operative device and that the other party therefore has a right to make the claim, gives **no** right of appeal to the moving party. Note, that the same motion is appealable to two different appellate tribunals according to the **reasons** for which the motion is allowed or denied and that a decision by the Primary Examiner against the moving party, who raises this "foundation" question, gives no right of appeal whatever under paragraph 2 of Rule 124 and is a final and unreviewable decision, binding upon the parties and binding also upon the Examiner of Interferences (Rule **126**).* (122, p. 2, ante)

*126. The Examiner of Interferences or the Examiners-in-Chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122) or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may, before judgement on the

It is obvious, as a matter of common sense and common justice that a decision upon a **fundamental question** by a primary tribunal should be reviewable and should not be finally determined by any one man, however upright and learned, and more especially when the moving party, upon a motion to dissolve based upon one of these fundamental grounds, is sent for a decision upon his motion to the very tribunal which has already, in the declaration of the interference, committed itself to the proposition that the interference is proper. It is a heavy handicap for the moving party in any event to overcome the natural pre-judgment of the tribunal, without being irrevocably bound by the decision.

The Court of Appeals of the District of Columbia, notwithstanding its decision in this case, that the moving party Lowry had no statutory right of appeal and was irrevocably bound, recognized the gross injustice of such a pocedure, in the very recent decision of Podlesak v. McInnerney, 120 O. G. 2127, in which the Court, by Mr. Justice Duell, says:

> "The question of the right of a party to make the claim goes to the **very foundation** of an interference, for if the party has not such a right the interference falls. If it be incorrectly held that such a party has a right to make the claim, priority

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question of priority, suspend the interference and remand the case to the Primary Examiner for his consideration of the matters to which attention has been directed. From the decision of the Examiner appeal may be taken as in other cases. If the case shall not be so remanded, the Primary Examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

may be awarded to him and his adversary be deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. **Manifestly that question should not be finally determined by the Primary Examiner** who originally declared the interference."

It is obviously the opinion of the Court of Appeals, when Allen v. U. S. **ex rel.** Lowry (the present case) is considered in connection with the later case of Podlesak v. McInnerney, that a review should have been given as a matter of justice but that the statutes do not require it.

In the conclusion of the Court that the statutes do not provide for a review of such a "foundation question" the plaintiff in error disagrees and contends that upon the face of Sec. 4909, as a matter of plain English, and upon settled principles of statutory construction, it is absolutely clear that the plaintiff in error, Lowry, being a "party to an interference" . . . "may appeal from the decision of the Primary Examiner" . . . "to the Board of Examiners-in-Chief."

Upon the face of Sec. 482 as a matter of plain English the plaintiff in error contends that it is the duty of the Board of Examiners-in-Chief to entertain the appeal thus provided in Sec. 4909: "whose duty it shall be on the written petition of the appellant to revise and determine upon the validity of the adverse decisions of Examiners . . . in interference cases."

Section 4909 creates a statutory right.

> Sec 4909: Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and **every party to an interference, may appeal from the decision of the Primary Examiner**, or the Examiner in charge of

Interferences in such case, **to the Board of Examiners-in-Chief**; having once paid the fee for such appeal

Section 482 creates a statutory duty.

Sec. 482: The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose **duty** it shall be, on the written petition of the appellant **to revise and determine upon the validity of the adverse decisions of examiners** upon applications for patents, and for reissues of patents, and **in interference cases**; and when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

STATUTORY CONSTRUCTION.

It is elementary law in statutory construction that, in the interpretation of any statute, the ordinary meaning of its words and language must be controlling.

Maillard v. Lawrence, 16 How. 251.

The intent of the Legislature is, of course, to be considered, in construing the statute, but that intent is to be discovered from the statute itself in its various parts and not from considerations **dehors** the statute.

U. S. v. Wiltberger, 5 Wheaton, 76.

Unless the statute itself be ambiguous or contradictory in its parts.

Ruggles v. Illinois, 108 U. S. 526.

But where the statute is not ambiguous there is no room for construction, no reason for resort to extrinsic evidence of the intention of the law makers.

Ruggles v. Illinois, 108 U. S. 526.

Pitman v. Flint, 27 Mass. 504.

And an argument of inconvenient results or even

gross injustice can have no weight where the statute is plain and unambiguous.

Putnam v. Longley, 28 Mass. 487.
Pitman v. Flint, 27 Mass. 504.

COURSE OF LEGISLATION.

While evidence of the intention of the Legislature must be sought in the statute which is to be construed, it is supposed that the general course of legislation dealing with appeals in the Patent Office may be pertinent and cast a light upon the intention of the Legislature in enacting Sections 482 and 4909.

As a basis for consideration of this sort and in support of the contention of the plaintiff in error that the course of prior legislation on this subject indicates that the Congress intended an appeal to lie in a case like the present, a very succinct history of the prior legislation bearing upon the subject will be undertaken.

PRIOR LEGISLATION.

By the first Patent Act of 1780 (1 Stat. 109), the Secretary of State, the Secretary of War and the Attorney General were given power to grant patents, without examination as to novelty or originality.

By the Act. of 1793 (1 Stat. 318), the Secretary of State was made the agency for the grant of patents and provision was made, in the case of interfering applications that the claims of the rival applicants should be submitted to three arbitrators, whose decision was final.

By the Act of 1836 (5 Stat. 117) the Patent Office was established and the Office of Commissioner of Patents created, and the Commissioner was required "to make, or cause to be made, an examination of the alleged new invention or discovery," and the Com-

missioner was given authority to appoint an examining clerk to assist him in his duties. Provision was also made for a special Board of Examiners, consisting of three disinterested persons, to entertain appeals from the Commissioner. This Board was a temporary Board appointed for each occasion.

The Act of 1839 (5 Stat. 353) increased the examining force and gave an appeal from the Commissioner of Patents to the Chief Justice of the District Court of the United States for the District of Columbia, the appeal to a temporary Board of Examiners being done away with.

By the Act of 1849 (9 Stat. 395) the Patent Office was transferred to the Department of the Interior from the Department of State.

By the Act of 1852 (10 Stat. 75) the right of appeal from the Commissioner of Patents was extended to include the assistant judges of the Circuit Court of the District of Columbia.

It will be noted that up to this time the Commissioner of Patents is **himself** the Primary Examining Agency, having clerical assistants, with provision for appeal from the primary decisions of the Commissioner to other tribunals, temporary or permanent.

The Act of 1861 (12 Stat. 246) is as follows:

> "Sec. 2. And be it further enacted, That for the purpose of securng greater uniformity of action in the grant and refusal of Letters Patent, there shall be appointed by the Pesident, by and with the advice and consent of the Senate, three Examiners-in-Chief, at an annual salary of $3000. each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine

upon the validity of decisions made by Examiners when adverse to the grant of Letters Patent, and also to revise and determine in like manner upon the validity of the decisions of Examiners in interference cases, and when required by the Commissioner in applications for extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said Examiners-in-Chief shall be governed in their action by the Rules to be prescribed by the Commissioner of Patents."

"Sec. 3. And be it further enacted, That no appeal shall be allowed to the Examiners-in-Chief from the decisions of the Primary Examiners, except in interference cases, until after the application shall have been twice rejected; * * * * * *"

This act created a revolution in the Patent Office in its theory and mode of operation. The Examiners, formerly the Commissioner's clerical assistants, became under the Act of 1861 the tribunal of first instance. The Commissioner became an appellate tribunal and the newly-created Board of Examiners-in-Chief became an an **intermediate** appellate tribunal between the Primary Examiners and the Commissioner of Patents.

It will be observed that the Examiners-in-Chief under the Act of 1861 derived their authority directly from the statute and that their duty is clearly set forth by the statute and that their office comes by direct appointment of the President, by and with the advice and consent of the Senate.

It is fair to say, therefore, that the Board of Examiners-in-Chief thus created is an independent, intermediate, appellate tribunal, whose jurisdiction and

duty is created and defined by the statute.

By the Patent Act 1870 (Sec. 2), superseding prior legislation, it is enacted that:

> (R. S. U. S. Sec. 476.) "There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner and three Examiners-in-Chief, who shall be appointed by the President . . . all other officers . . . authorized by law for the office shall be appointed by the Secretary of the Interior."

Section 4 of the Patent Act of 1870 is as follows:

> (R. S. U. S. Sec. 440.) "There shall also be in the Department of the Interior . . . In the Patent Office: One Examiner in charge of Interferences."

Section 10 of the Patent Act 1870 is as follows.

> (R. S. U. S. Sec. 482.) "The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of Examiners upon applications for patents, and for reissues of patents, and in interference cases."

Section 19 of the Patent Act 1870 is as follows:

> (R. S. U. S. Sec. 483.) "The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

Section 42 of the Patent Act of 1870 is as follows:

> (R. S. U. S. Sec. 4904.) "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee, as the case may be, and shall direct the Primary Examiner to proceed to deter-

mine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor unless the adverse party appeals from the decision of the Primary Examiner, or the Board of Examiners-in-Chief, as the case may be, within such time, not less than 20 days, as the Commissioner shall precribe."

Section 46 of the Patent Act of 1870 is as follows:

(R. S. U. S. Sec. 4909.) "Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the Primary Examiner, or of the Examiner in charge of Interferences in such case, to the Board of Examiners-in-Chief; having once paid the fee for such appeal."

Section 47 of the Patent Act of 1870 is as follows:

(R. S. U. S. Sec. 4910.) "If such party is dissatisfied with the decision of the Examiners-in-Chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

By the Act of February 9, 1893, the jurisdiction of the Supreme Court of the District of Columbia upon appeals from the Commissioner of Patents was vested in the newly-created Court of Appeals for the District of Columbia. And by Sec. 9 of that Act it was enacted that "Any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

The above sections are those which are pertinent to the matter of appeals in interference cases. Of the statutes cited Sections 2, 4, 10, 19, 42, 46 and 47 of the Patent Act of 1870 have become respectively, Sections 476, 440, 482, 483, 4904, 4909 and 4910 of the Revised Statutes of the United States.

Section 2 of the Act of 1861, Sec. 482, Sec. 4904,

Sec. 4909, Sec. 4910 R. S. U. S. and Sec. 9 of the Act of February, 1893, all specifically relate to appeals in interference cases, and in every one of these sections it is provided that **both** parties in the interference have the right of appeal in interferences, from the Primary Examiner. (Secs. 4904, 4909.)

Note that Sec. 4909 distinctly refers both to the Primary Examiner of Interferences and to the Primary Examiner (mechanical) thus making it clear that there is no confusion as to just which Primary Examiner it was intended to give an appeal from.

Note that Secs. 4909 and 482 distinctly refer to appeals both in ex parte cases and in interference cases thus making it clear that appeals in both classes of cases from both classes of examiners were contemplated by the Legislature.

It will be observed that by Sec. 482, certain changes are introduced over the Act of 1861, Sec. 2, namely, whereas under the Act of 1861 the jurisdiction of the Examiners-in-Chief attached "on the written petition of the **applicant;**" under the Act of 1870 the jurisdiction of the Examiners-in-Chief attached "on the written petition of the **appellant.**" Also that whereas under the Act of 1861 it was the duty of the Board upon petition of an **applicant** "to revise and determine upon the validity of decisions made by Examiners when adverse to the grant of Letters Patent," and also "to revise and determine in like manner upon the validity of decisions of Examiners in interference cases," under the Act of 1870 the duty is set out "on the written petition of the **appellant** to revise and determine upon the validity of the adverse decisions of Examiners upon applications for patents, and for reissues of patents, and in interference cases."

INFERENCES FROM "COURSE OF LEGISLATION."

It is clear upon consideration of the statutes above quoted that it was the intent of Congress to erect in the Patent Office a Board composed of persons learned in the law and in science. (Act of 1861, Sec. 10 of Act of 1870 and R. S. U. S. §482.)

> "The examiners in charge shall be persons of competent legal knowledge and scientific ability."

The object of creating such a Board being to give uniformity and continuity to the practice and decisions of the Patent Office. The preamble to the Act of 1861 shows this:

> "And be it further enacted, that for the purpose of securing greater uniformity of action in the grant and refusal of Letters Patent."

It is also clear upon consideration of the statutes above that the **right of review** by this specially qualified Board of Examiners-in-Chief, which was clearly intended to serve as a fly wheel for the Patent Office, **was intended to be secured to ALL parties upon ALL material questions**. Language could not be more explicit to that effect.

> "Sec. 482. The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability whose **duty** it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of Examiners upon applications for patents and for reissues of patents and in interference cases."
>
> "Sec. 4904. And the Commissioner may issue a patent to the party who is adjudged the prior inventor unless the adverse party appeals from the decision of the Primary Examiner or the Board of Examiners-in-Chief, as the case may be."
>
> "Sec. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which

have been twice rejected and **every** party to an interference may appeal from the decision of **the Primary Examiner** or of the Examiner in charge of interference in such case **to the Board of Examiners-in-Chief,** having once paid the fee for such appeal."

Attention is called to the fact that there is no provision in the statutes for **any** appeal upon **any** question from **any** of the primary tribunals, direct to the Commissioner of Patents, but, on the contrary, explicit provision that the line of appeal shall be from the Primary Examiner, whether he be Mechanical Examiner or the Interference Examiner, to the Board of Examiners-in-Chief and from the Board of Examiners-in-Chief to the Commissioner in person.

A comparison of Rule 124 with these statutory requirements as to appeals shows that the rule practically nullifies the statutory provisions and practically eviscerates the jurisdiction of the Board of Examiners-in-Chief, since it provides that.

"124. Appeal may be taken **directly to the Commissioner** from decisions on **all** motions except the following:

(1) On motions to dissolve which deny the patentability of applicant's claim;

(2) Upon motions to dissolve which deny the right of an applicant to make the claim;

(3) On motions involving the merits of the invention.

Under the motions thus made appealable to the Commissioner of Patents directly is the appeal on motion to dissolve on the ground of "no interference in fact," which is held to mean that the rival specifications do not **describe** the same invention, **i. e.,** a pure question of legal construction of documents is taken from the only tribunal in the Office required by law to have

legal knowledge, direct to the Commissioner, who may be, but is not required to be, a lawyer. (See table of appeals below.)

By the second paragraph of Rule 124, the right of appeal, even on the three motions which appear by paragraph 1 of the rule to be appealable elsewhere than to the Commissioner in person, is further restricted (Rule 124, Par. 2) since "from a decision affirming the patentability of the claim or the applicant's right to make the same, **no appeal can be taken.**"

Thus, of the three matters which by paragraph 1 of Rule 124 are appealable elsewhere than to the Commissioner in person, two are appealable only in favor of one party to the interference and the other party, upon an adverse decision of these two questions, is denied any right of appeal whatever.

MOTIONS HEARD BEFORE THE PRIMARY MECHANICAL EXAMINER AFTER DECLARATION OF INTERFERENCE.

Motions to dissolve on the ground of

(a) No interference in fact (construction of rival specifications). Appeal for **both** parties to the Commissioner.

(b) Irregularity in declaration. Appeal for **both** parties to the Commissioner.

(c) Claim unpatentable. Appeal for **one** party only to the Board of Examiners-in-Chief.

(d) No right to make the claim. Appeal for **one** party only to the Board of Examiners-in-Chief.

(e) Motion to shift the Burden of Proof. Appeal for **both** parties to the Commissioner.

(f) Motion to Reform the Interference. Appeal for **both** parties to the Commissioner.

Prior to 1870 the various Primary Examiners decided **all** questions arising in an interference and from decisions an appeal might be taken to the Board of

Examiners-in-Chief. (Opinion below, Record, p. 30.)

Under the Patent Act of 1870, Section 4, provision was for the first time made for an "Examiner in charge of Interferences" and for some little time after the creation of this officer he had entire charge of **all** matters relating to interferences and an appeal lay to the Board upon **all** questions.

(Opinion below, Record, p. 32.) "The act of 1870 having provided for an Examiner of Interferences, provision was made in Rule 59, of July 15, 1870, for their trial before such officer. Its full provisions are as follows:

> "59. Cases of interference will, when the issue is made up and the testimony taken, be tried before the Examiner of Interferences. If the interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, **unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists."**

Subsequently to the Act of 1870 the Commissioner, under his supervisory power (Sec. 483) took from the Examiner in charge of interferences created by the Act of 1870, the decision of every "fundamental" question in an interference except the bare question of dates, namely, such questions as those relating to the meaning of the rival specifications ("interference in fact") and those relating to the operativeness of the rival devices ("right to make claim" and "patentability" etc.) and, that the fact that the Interference Examiner was the "Examiner in charge of Interferences" (Sec. 440) might be emphasized, made the decisions of the Primary Examiner, to whom the jurisdiction

was thus shifted, binding upon the Interference Examiner (Rule 122). This action of the Commissioner restored to the Primary Examiners nearly all the interference jurisdiction that they had, prior to the creation of the Interference Examiner by the Act of 1870.

Under the Act of 1861 the interference being decided by the Primary Examiner (mechanical) was appealable to the Board of Examiners-in-Chief. Under the act of 1870 the interference being decided by the Primary Examiner of Interferences was appealable of the Board of Examiners-in-Chief.

The first change in the jurisdiction of the newly-appointed Examiner in charge of Interferences was effected by Rule 59, paragraph 2 (amendment of 1871), which provided for a hearing of a motion to dissolve by the Primary Examiner who declared the interference. No provision by the Rule for appeal from this action, was provided. Apparently this point was raised, for September 1st, 1873, the following clause was added to the rule:

> "Upon such hearing the Primary Examiner will **recommend** the granting or refusal of such motion, and the Examiner in charge of Interferences **will order accordingly.**"

This rule, so amended, is absolutely according to the statute, since it leaves the actual decision or order on the matter to the Examiner of Interferences, from whom appeal lay beyond peradventure. It is obvious that here is a perfect model for a lawful practice, under which the work may be divided, yet full right of appeal secured at a convenient time.

From that time on, as the history of Office practice described by the Court below in the opinion shows,

the rules have receded from the statutes, at first directing appeal direct to the Commissioner (Rule 59 of April 1, 1875) and finally (Rule 116 of Dec. 1, 1879) denying to one party **any** appeal (Record, p. 33).

[These statements of **fact** as to ancient Office practice are from the Opinion of the Court below (Record, p. 33)].

The practice under Rule 124, provided that the question, namely, priority of date, still left in the hands of the Primary Examiner of Interferences, should be appealable to the Board of Examiners-in-Chief. But those questions taken from the Examiner of Interferences and restored to the Primary Examiner (mechanical) for decision are made appealable in part directly to the Commissioner of Patents (interference in fact, that is, construction of the rival specifications) and partly to the Board of Examiners-in-Chief (decision on motion to dissolve that the party has no right to make the claim and that the claim is not patentable) and partly all appeal is denied (decision, on motion to dissolve, that the party has a right to make the claim and that the claim is patentable).

It is obvious that the Office practice under Rule 124, as to appeals within the Office, has very little antecedent in the statutes, which nowhere provide for any direct appeal to the Commissioner and which do affirmatively provide that all appeals shall be to the independent, intermediate, appellate tribunal, the Board of Examiners-in-Chief, and that **every** party to an interference may have such an appeal either from the Examiner of Interferences or from the Primary Examiner, and not merely such parties as the Commissioner chooses to select.

THE OPINION OF THE COURT BELOW.

The Court below, by implication, admits that, upon its face, the statutes give the right of appeal which is here claimed by the plaintiff in error, since the Court finds it necessary to reconstruct Sec. 4909 by omitting certain words, adding other words, and rearranging sentences of the section to give an entirely different grammatical construction. The section clearly means one thing before this operation by the Court is performed, and means something else after it has been operated upon.

By the Court:

> (Record, p. 36.) "In the light of the previous statutes we think that the proper construction to be placed on this section is as though it read, every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary Examiner and every party to an interference may appeal from the decision of the Examiner in charge of interferences in such case to the Board of Examiners-in-Chief."

Comparing this construction of the statute with the statute itself, it will be found that it injects several words into the section and strikes out several words from the section and rearranges the words and sentences so as to entirely change their grammatical connection. The words enclosed in brackets are read into the statute; the words enclosed in parenthesis are struck out of the statute.

> "Every applicant for patent or for the reissue of a patent any of the claims of which have been twice rejected, [may appeal from the decision of the Primary Examiner] and every party to an interference may appeal from the decision of the

(Primary Examiner or of the) Examiner in charge of interference in such case to the Board of Examiners-in-Chief.

REASONING OF THE OPINION.

This gloss upon the section is justified by the Court below upon the ground of CONGRESSIONAL INTENT "in the light of the previous statutes." All the statutes bearing upon the matter, so far as the writers are aware, have been cited and quoted, and it will be seen that so far from these statutes indicating an intention that the decision of the Primary Examiner (mechanical) in an interference should be final and absolute, especially when the question decided "goes to the very foundation of the interference" (Podlesak v. McInnerney, 120 O. G. 2127.) the statutes seem to indicated a very distinct intent to make elaborate and careful provision for a proper review of all questions arising in the Patent Office, since the statutes erect a special tribunal of three members to hear and revise **all** decisions of **all** Primary Examiners whether the Interference Examiner or the Primary Examiners (mechanical). (See Sec. 482 and 4909.)

The Court below summarizes its reasons and conclusions at the end of the opinion and that summary, stating as it does the reasons of the Court, may well suffice for a text for this brief, the reasons advanced being taken up and discussed **seriatim.**

From the Opinion (Record, p. 38).

> "We are clearly of the opinion that the Court below erred in granting the petition for the writ of mandamus. Our reasons, summarized, are these: That a motion to dissolve an interference before the final hearing of the question of priority and before the case is ready for such hearing, is an interlocutory proceeding and is not appeable

unless made so by statute or rule of Court; that no statute and more specifically stated, neither sections 482, 4904, 4909 of the Revised Statutes, nor any rule of the Patent Office made by the Commissioner, gives the right of appeal to the Examiners-in-Chief from decisions made by the Principal Examiners on the hearing of a motion to dissolve, holding that a party has the right to make the claim which is the issue of an interference; that where the statute gives the right of appeal in interferences from decisions of any officer of original jurisdiction, it means final decisions; that the right to such an appeal should be clear, and that if there is any doubt, although we believe there be none, as to the construction of the statutes claimed to confer the right, such doubt should be resolved in favor of the long-established and acquiesced-in practice of the Patent Office which, we believe, is in the interest of interferants; that the provision for interlocutory motions to dissolve interferences is the creature of a rule and not founded on statutory enactment and that a party to an interference is not deprived of any statutory right to an appeal by reason of the rules not providing for an appeal from a decision of the Examiner that a party has a right to make the interfering claim; that whatever right a party to an interference has to contest the right of his adversary to make the interfering claim, such right if denied is reviewable, if at all, upon the final decision of the question of priority, and such right of appeal as he has to have that question decided is to be considered on the hearing of the statutory appeals allowed from the decision of the question of priority by the Examiner of Interference."

The points made by the Court below in support of its construction of the statutes may be summarized as follows:

A. A Motion to Dissolve before final Hearing of the Question of Priority is Interlocutory and not Appealable.

(a) unless made so by rule or statute;

(b) that no statute or rule makes a motion to dissolve, such as is here in issue, appealable.

B. That the appeals given by the statute are from final decisions.

C. That motions to dissolve are the creatures of rule and that the parties are not deprived of any statutory right by reason of the rules not providing for any appeal.

A. A MOTION TO DISSOLVE BEFORE FINAL HEARING OF THE QUESTION OF PRIORITY, IS INTERLOCUTORY AND NOT APPEALABLE.

The answer to this is, that the decision by the Primary Examiner, of which Lowry seeks a review, is not properly interlocutory and it cannot be made interlocutory by so labelling it. The question of operativeness of the device of one of the contestants is inextricably bound up with the question of priority since, if one of the parties shows an inoperative device, he has completed no invention and cannot be the prior inventor, and its character as a **fundamental** question in the case, cannot be altered by the mode by which the Commissioner **compels the parties to raise it for decision.**

As the Court says:

> Podlesak v. McInnerney, 120 O. G. 2127 (C. A. D. C. 1906).
>
> "The question of the right of a party to make a claim goes to the **very foundation** of an interference, for if the party has not such right, the interference falls. If it be incorrectly held that such a party has a right to make the claim, priority

> may be awarded to him and his adversary deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the Primary Examiner who originally declared the interference."

When **all** questions in an interference were decided by a Primary Examiner, prior to the Act of 1870, which first created an Examiner in charge of Interferences, an appeal and review of all questions, lay to the Board of Examiners-in-Chief from the decision on all questions of the Primary Examiner. This the Court below admits (Opinion, Record, p. 30, near top).

When **all** questions in an Interference were decided by the Examiner in charge of interferences, after the Act of 1870, these "fundamental" questions of operativeness, etc., were decided by him as well as the other fundamental question of **priority** of date, and his decision on all these questions was appealable to the Board (Record, p. 30).

And the interference was authorized by Congress, presumably, as much to decide one "fundamental" question as another and it was, presumably, the intention of Congress that a review should be provided as well of a decision on one "fundamental" question as on another, and such a review was originally provided by appeal from the Primary Examiner and later from the Examiner of Interferences.

If the Commissioner chooses to take the decision of **every** "fundamental" question in an interference, but the question of priority in date, away from the Examiner **in charge** of Interferences and give it to some other Primary Examiner for decision, he cannot assume that the Congress did not INTEND to give a

review of decisions on these fundamental questions, in the face of the statute, because, by this shift of jurisdiction, it becomes necessary for the parties to take up these fundamental questions separately, before the Primary Examiner, and before the question of priority in date is taken up at final hearing before the Examiner of Interferences, rather than, as was originally practiced, taking up all the fundamentals together before the Examiner of Interferences and appealing all questions together from the Examiner of Interferences.

It is a grossly unfair position for the Office to take, that it can avoid the effect of a statute which makes provision for a review which the Office does not care to give, by shifting the work of deciding certain "fundamental" questions from the Examiner of Interferences to the Primary Examiner, and that the fundamental questions thus shifted become "interlocutory" questions and not appealable, and argue that, although it happens that the statute fits the new dispensation literally and provides in set terms for appeals from decisions of Primary Examiners in Interferences, Congress could not have **intended** this, because, when the section was enacted, Congress did not know that the Commissioner would shift the jurisdiction on these fundamental questions to the Primary Examiner, as he subsequently did.

The statute gives the right in terms and it is easier to suppose that Congress recognizing the possibility of shifts of jurisdiction by the supervisory and directory power of the Commissioner under Sec. 483, which was enacted at the same time, meant to provide generally, for the present and the future, that **all** questions decided by **all** Primary Examiners in **all** proceedings should be appealable to the Board.

A. A motion to dissolve is interlocutory and not appealable,

(a) unless made so by rule or **statute.**

The answer to this is to be found in the statutes:

> Sec. 4909. * * * * * * every party to an **interference** may appeal from the decision of the **Primary Examiner** * * * * * * in such case, to the Board of Examiners-in-Chief."

A(b) "That no statute, and more specifically stated, neither Secs. 482, 4904 nor 4909 of the Revised Statutes, nor any rule of the Patent Office made by the Commissioner, gives the right of appeal to the Examiners-in-Chief from decisions made by the Principal Examiner on the hearing of a motion to dissolve, holding that **a party has the right to make the claim which is the issue of the interference.**"

Note how carefully this statement is limited. So limited it is literally true, since Rule 124, while giving appeals on decisions made in interference cases by a Primary Examiner, both to the Commissioner and to the Board, and even an appeal **on this very question** when the decision is that a party has **no** right to make the claim, **forbids,** by Par. 2 of Rule 124, an appeal from this specific decision. (See Table of Appeals, **ante** p. 22.) It is also literally true that no statute specifically authorizes an appeal from this particular decision. Such specific authorization was unnecessary. The statute is **general.**

> "Sec. 4909. * * every party to an interference may appeal from the decision of the Primary Examiner * * * in such case to the Board of Examiners-in-Chief."
>
> "Sec. 482. The Examiners-in-Chief * * * whose duty it shall be on the written petition of the ap-

pellant [changed from "applicant" in Act of 1861] to revise * * the adverse decisions of Examiners * * * in interference cases."

B. That the appeals given by the statute are from final decisions.

The statute does not use the qualification "final." It says merely "decisions." But, as is pointed out above, and as is admitted by the Court of Appeals in Podlesak v. McInnerney, cited above, the question of operativeness is **fundamental.** Until the Commissioner interfered with the jurisdiction of the Examiner of Interferences and restored to the Primary Examiner, jurisdiction of all matters in an interference save the bare question of dates, these fundamental questions might have been taken up before the Examiner of Interferences at final hearing and an appeal had. The Court now holds that since the effect of the shift of jurisdiction is to prevent this and compel the party to go before another Examiner on motion, these fundamental matters have become interlocutory and therefore not appealable. The Commissioner has explicitly ruled that such a matter as is here appealed is a decision in an interference.

Newcomb v. Lemp, 110 O. G. 307.

The Court of Appeals has also found that the decision of such questions "manifestly" should not be finally determined by the Primary Examiner.

The statute covers such decisiones as are here in question in explicit terms.

To what end should the statute be construed to say the very reverse of what it does in fact say?

Construed as the plaintiff contends it should be, as a matter of plain English, it gives a review of the decision of the lowest tribunal in the Patent Office upon

a fundamental question, which, before the motion to dissolve was brought, this tribunal had prejudged in declaring the interference. Obviously, such a tribunal's decision on such a fundamental question should be reviewed.

Construed as the Court construes the section, the decision of the Primary Examiner, the lowest tribunal in the Office, and a tribunal prejudged before the motion is made, upon a fundamental question, is made final. The aggrieved party is forbidden to appeal--"no appeal can be taken" (Par. 2 Rule 124). Why should the statute be reorganized to effect such an unjust result?

If the plain construction of the statute for which the plaintiff in error contends, led to an unjust result, and if the reconstruction of the statute for which the Commissioner of Patents contends and which the Court of Appeals approves, led to a just result, it is conceivable that a Court might strain a point in construction in order to avoid an unjust result and reach a just result. But, as has been pointed out, the effect of the construction for which the plaintiff in error contends, is to give a just result, namely, a right of review upon a fundamental question in the cause, while the construction urged by the Commissioner of Patents reaches an unjust result, namely, that the right of review upon a fundamental question in the cause is denied, and the decision of the lowest tribunal of the Patent Office made final and unreviewable by the mere fiat of the Commissioner of Patents, in direct violation, not only of the spirit of all common law proceedings and of the spirit of all the statutes bearing upon appeals in the Patent Office but of the Express terms of the statute, Secs. 482 and 4909.

Obviously the inference of Congressional intent, if

it is to be drawn from the statutes or the course of legislation, supports the plaintiff in error, who now claims a right of appeal on a question formerly appealable and reviewable when the entire interference was in the hands of the Primary Mechanical Examiner prior to 1870, and when later, the entire interference was in the hands of the Primary Examiner in charge of interferences (Act of 1870). It is obvious therefore, that Congress intended such questions to be **reviewed.**

The view of the relator is the reasonable view: That Congress recognized the fact that the Commissioner would have power under Sec. 483 R. S. U. S. (enacted at same time as Sec. 482 and Sec. 4909) to regulate proceedings in the Patent Office, and to distribute the work of the Office among his various subordinate tribunals in his discretion and **intended to provide, in general terms** that **all** questions decided by **all** the Primary Tribunals should be reviewable upon appeal by the newly-constituted Board, no matter how the Commissioner in his discretion might distribute the work of making primary decisions. Congress certainly did **not** intend that a fundamental question in an interference which was appealable and reviewable when the statute was passed, should by a juggling of the distribution of work between two primary tribunals, be made unreviewable, with the result that a question which might be decisive of the case, and in any event, was of fundamental importance to the proper decision of the case, should be made final with the lowest official in the Patent Office, in the present case, for example, an Assistant Primary Examiner.

There is no system of jurisprudence—no trial system —in which the final disposition of substantial questions in a case is made dependent on one man.

Every system recognizes that the best and wisest man may be subject to abberrations and that, therefore, there is safety in numbers, since a number of men are necessarily less liable to such abberrations. Hence, in all systems, sooner or later there is provision for review of all substantial questions by an appellate tribunal. In the Patent Office alone is the determination of a substantial question by one man made final, and, be it noted, that the tribunal selected as the repository of such unchecked power is not even the head of a department or some officer presumably trained in the consideration of disputes, but merely a skilled mechanician, who need not necessarily have either natural or acquired judicial capacity. In the case at bar the decision was made by an Assistant Primary Examiner.

C. "That the provision for interlocutory motions to dissolve interferences is the creature of a rule and not founded on statutory enactment and that a party to an interference is not deprived of any statutory right to an appeal by reason of the rules not providing for an appeal from a decision of the Examiner that a party has a right to make the interfering claim."

The fact that appeals are in fact allowed under Rule 124, from decisions of the Primary Examiner in interference cases (see Table, **ante**, p. 22) was met by counsel for the Commissioner below, by the statement that these appeals were not the appeals provided by statute.

(Commissioners Brief, below). "The Commissioner, as the head of the Office, has concluded to review the interlocutory rulings upon certain questions prior to final hearing, but this is not the appeal provided for in the statutes (Sections 4909 and 4910). It is something he can do and

has done for many years, but that he is not required by statute to do."

To the opponents it seemed more reasonable to regard the appeals provided for by Rule 124 as an admission that the rulings of the Primary Examiner in interference were legally reviewable. But the attitude of Counsel for the Commissioner was, as the excerpt shows, that the Commissioner gave and the Commissioner hath taken away.

This position would be more sound, and the position of the Court below more logical, it is submitted, if the major premise, that motions to dissolve are the "creature of a rule" were true.

Obviously it is not. First, because no rule of the Patent Office even purports to create the right, though some of the rules cited by the Court below do purport to regulate its exercise, and second, because, even if a rule did purport to create the right, it would be merely declaratory, since the right to raise any proper question by motion, is inherent at common law. A motion is the time-honored method of bringing any proper matter to the attention of the tribunal. The Commissioner is mistaken in supposing, that if, by mistake, an inexperienced Examiner put into interference the inventors of a churn and a plow, and one of the parties desired to call the attention of the tribunals of the Office to the error, he would be unable to make a "motion to dissolve" upon the ground of the error, in the absence of a specific rule, but would be compelled to go to trial upon the bare question of when, as matter of date, did A invent his churn and B his plow, priority being awarded to the earlier in date, in the invention of the other. Under such circumstances either party might make a motion to dissolve the interference or any motion raising the point, **rule**

or no rule. There is no rule of the Patent Office now, and so far as considerable research can show, there never has been a rule, even purporting to give the right to make motions to dissolve.

The Court below quotes ancient rules of the Patent Office (Record, p. 32) to show that motions to dissolve are the creatures of the rules. It is curious to note that not one of these old rules even purports to confer this right, but merely provides for the regulation of its exercise.

The Court below, it is submitted, is mistaken in supposing that Rule 122 or any other rule creates the right and therefore is mistaken in its predicate that the right to make such motions is "the creature of a rule."

A small argument was made below to the effect that the allowance of such an appeal as is here claimed would inconveniently multiply proceedings. The argument is evidently not sincere, in view of the fact that appeals are allowed, as is shown by the Table, (above, p. 22), on almost all questions raised by motions to dissolve except the most fundamental questions of all, namely, the patentability of the claim and right to make the claim, and even upon these questions appeal is allowed to one party although denied to the other.

It is not seen that there is any special inconvenience in allowing an appeal to the moving party upon a motion to dissolve based on the above-mentioned grounds.

But whether or not it is inconvenient is, as matter of law, immaterial, if the legislature has so ordained.

Putnam v. Longley, 28 Mass. 487.

Pitman v. Flint, 27 Mass. 504.

The legislative will in such a matter must be obeyed by the executive, whether or not it be inconvenient or even if the results be highly unjust.

A practical answer, however, which shows that the argument of inconvenience is not a sincere argument, is, that all inconvenience may be avoided by the simple expedient of **regulating** the time when the appeal may be prosecuted. The Commissioner under his supervisory power (Sec. 483) may make rules, not inconsistent with law, to regulate matters in the Patent Office. He may, therefore, lawfully make a rule that the appeal, as specifically provided for by Sec. 4909, shall be heard by the Board of Examiners-in-Chief when the appeal from the Examiner of Interferences upon the other branch of the case (dates) is reached. Or all inconvenience may be avoided by reverting to the practice that originally prevailed in the Patent Office, immediately after the creation of the Examiner of Interferences, when Motions to Dissolve, raising mechanical questions, were referred to the Primary Examiner for a Report and on this Report the Examiner of Interferences decided the Motion, thus preserving the right of review, on appeal from the Examiner of Interferences. (See Opinion, Record, p. 33, line 10, et seq.)

In this way any multiplication of proceedings will easily be prevented and the appellate tribunals will not be called upon to consider the case until **all** questions involved are ripe for decision. **In this way the two halves of the case, divided by the Commissioner in its trial stage, between two primary tribunals, will be reunited before the appellate tribunal.**

For the logical and scientific procedure of appeal provided by the statutes, the Commissioner has substituted a system of appeal which utterly disregards

the statutes and violates the fundamental principles of law. The first paragraph of Rule 124 provides that **all** matters raised upon motions to dissolve, except certain specified exceptions, shall go upon appeal, direct to the Commissioner. This provision is obviously unlawful since the statutes provide that **all** appeals from **all** the lower tribunals of the Office, involving questions of law and questions of fact, shall go upon appeal to the independent, intermediate, appellate tribunal, the Board of Examiners-in-Chief, which is especially constituted by the statutes and which is the only tribunal in the Patent Office required by law to have legal knowledge as well as scientific knowledge. By the second paragraph of Rule 124 one of the parties to an interference is forbidden any appeal whatever upon fundamental questions in the case, and the effect of this inhibition, if the party is supine enough to submit, is that the fundamental questions which the moving party on a motion to dissolve has raised become **res adjudicata** and can nowhere, at any subsequent stage in the proceedings, be raised for review, since it is elementary law that appellate tribunals can review only **decisions**, and if a decision is made below and the party aggrieved makes no appeal, he is finally bound by the decision.

For the logical and scientific procedure of the statute, the Commissioner has substituted by Rule 124 a system which compels one of the parties to an interference to rest content with the judgment of a Primary Examiner (or even of an Assistant Primary Examiner as in the case at bar), upon the fundamental question whether the two parties to an interference do interfere by having made the same invention and whether the opponent's mechanism is operative to any useful purpose, thus depriving one of the parties to an

interference of the right to take the opinion of a Board composed of persons who not only are competent in scientific matters but are also competent to consider the questions of construction, i. e., legal questions, involved. Having deprived one of the parties of the right to appeal, by Rule 124, the Office substitutes by Rule 126 a procedure which provides that the Examiner of Interferences (who has left to him only jurisdiction of the mere question of dates) and the Examiners-in-Chief, may "direct the attention of the Commissioner to any matter not relating to priority" which may come to their notice. Whatever the reasons were that animated the officials of the Patent Office in devising this procedure, the result certainly is that it cuts down the rights of one of the parties to the interference and cuts down the jurisdiction of the Board of Examiners-in-Chief. This "directing the attention" is absolutely inconclusive and may or may not be taken note of by the Commissioner of Patents, who may (and frequently does) disregard these "directions" (Rule 126, line 9).

SUMMARY.

Rule 124, paragraph 1, is inconsistent with law because it requires an appeal from the Primary Examiner direct to the Commissioner. The statute makes no such provision but, on the contrary, provides that all appeals from the Primary Examiner shall be to the Board of Examiners-in-Chief (Secs. 482, 4909). The first paragraph of Rule 124, therefore alters the line of appeal and, in so far as it does this, is inconsistent with law and void.

Rule 124, paragraph 1, is inconsistent with law be-

cause it cuts down the jurisdiction of the Board of Examiners-in-Chief by altering the line of appeal.

Rule 124, paragraph 1 is inconsistent with law because it deprives the parties to an interference of the right of review of certain decisions of the Primary Examiner by a permanent and specially qualified legal and scientific tribunal, namely, the Board of Examiners-in-Chief. For example, the question of "interference in fact"—construction of the rival specifications—which is by Rule 124, made appealable to the Commissioner (see Table, **ante,** p. 22).

Rule 124, paragraph 1, is inconsistent with law because it deprives one of the parties to an interference of an appeal to the Board upon the decision by the Primary Examiner of a pure question of law, namely, interference in fact—construction of the rival specification; diverting the appeal from the tribunal required by law to have legal knowledge to another tribunal not so required.

Rule 124, paragraph 2, is inconsistent with law because it cuts down the jurisdiction of the Board of Examiners by denying to one of the parties to an interference his appeal to the Board, and is inconsistent with the performance of their statutory **duty.**

Rule 124, paragraph 2, is inconsistent with law because it forbids to one of the parties to an interference any appeal from certain decisions of the Primary Examiner in an interference case.

Rule 124, paragraph 2, is inconsistent with law because it therefore denies to one of the parties to an interference **any review whatever** of certain decisions of the Primary Examiner in an interference case, since if no appeal is taken no review can be had.

Rule 124, paragraph 2, is inconsistent with law because it denies to one of the parties an appeal to the

Board of Examiners-in-Chief upon a fundamental mechanical question in the case.

Rule 124 is inconsistent with law because it practically eviscerates the jurisdiction of the Board of Examiners-in-Chief as an appellate tribunal from the Primary Examiner in interference cases, leaving only two decisions appealable to **one** party (see Table, p. 22 ante).

The fact that by Rule 126 provision is made for "directing the attention" of the Commissioner to any matter not relating to priority which the Examiner of Interferences or the Examiners-in-Chief may find in the course of the proceedings which may or should affect the ultimate decision of the case, is no warrant for the arbitrary and illegal change effected by Rule 124.

The parties to an interference are not obliged to be contented with "sugestions" of the Board of Examiners-in-Chief or of the Examiner of Interferences which may or may not be acted upon by the Commissioner of Patents. The parties are entitled under the law to DECISIONS and nothing less than decisions will or can give the appellate tribunals of the Office or the Court of Appeals jurisdiction to review.

The procedure set up by Rule 126 has nothing antecedent in the statutes. So far as the procedure set up by Rule 126 is not made use of to cut down statutory rights and duties, but is merely an auxiliary procedure, it may be good; but no amount of auxiliary procedure to secure a proper disposition of cases by the tribunals of the Patent Office can excuse or warrant the change of the statutory provisions for the conduct of causes before the Patent Office tribunals.

The Board of Examiners-in-Chief is an independent, (Sec. 478) intermediate, (Secs. 4909, 4910) appellate

(Sec. 4909) tribunal taking, upon appeal, all questions decided by a Primary Examiner either **ex parte,** as between an applicant and the Patent Office or **inter partes,** in litigated interference cases (Sec. 4909).

The Primary Examiner of Sec. 4909, is not the Examiner of Interferences who is also mentioned in Sec. 4909 and thus distinguished from the Primary Examiner (mechanical).

The argument that a Motion to Dissolve is interlocutory since it is raised before final hearing by the Examiner of Interferences upon the question of dates, is met by the showing that the parties are compelled to raise these questions by motion since the Commissioner has taken from the Examiner of Interferences the decision of all fundamental questions in an interference, except the single question of dates, and restored jurisdiction to the Primary Examiners on these matters. The Commissioner cannot fairly say that he has thus made these "foundation" questions which, so long as they were left for decision to the Examiner in charge of Interference could be tried by and were appealable from the Examiner of Interferences, interlocutory and non-apealable, by his act in shifting jurisdiction. This is to take advantage of his own wrong. If they were fundamental and therefore reviewable questions before, they are fundamental and reviewable now and not interlocutory in any proper sense.

The Commissioner, to suit his own purposes, has divided the work of the trial tribunal into two parts, and claims that in so doing he is enabled to deny to one party, at his will and pleasure, any appeal upon the fundamental matters thus transferrd to the other trial tribunal

The argument that a motion to dissolve is interlocu-

tory, is further met by the statute, which expressly allows appeals from **all** decisions of a Primary Examiner (mechanical) in an interference case, so that whether they are interlocutory or not they are appealable.

The statute is general and provides for an appeal from all decisions by all Primary tribunals. The shift of jurisdiction from the Examiner of Interferences to the Primary Examiner (mechanical) did not therefore dodge the statute, which obviously contemplated such action as possible under Sec. 483 and was therefore made general in its terms.

The attempt to argue that the Congress could not have **intended** this effect of the statute is obviously not well based. Even it be conceded that a Motion to Dissolve upon the ground that the rival specifications do not describe the same invention and that the other party has completed no invention since his mechanism is inoperative, is technically interlocutory to the final question for consideration, namely, date of invention, it is obviously more just and reasonable that an appeal should lie from such an interlocutory matter, than that no review of the decision of a fundamental question, by the lowest tribunal in the Patent Office, should be had, which is the admitted effect of the inhibition or paragraph 2, of Rule 124.

> "From a decision of the Primary Examiner affirming the patentability of the claim or the applicant's right to make the same, **no appeal can be taken.**"

And in view of the fact that the statute does **in terms** provide for such an appeal and in view of the admitted fact that "manifestly" such a decision should be reviewed, the **natural** inference of intent is, that the Congress intended what it has in set terms said:

> "Every party of an interference, may appeal from the decision of the Primary Examiner * * * * * * in such case, to the Board of Examiners-in-Chief."

The reconstruction of the statute cannot be justified as necessary to avoid an unjust result and to attain a just result. Even if these ends were achieved it could not be accomplished in the face of the absolutely clear language of the Sections.

The reconstruction of the statute cannot be justified upon the ground of Congressional **intent,** since so far as the prior statutes show general intent, it is a general intent to erect an intermediate, especially qualified appellate tribunal, to take appeals from decisions **in interference matters** of Examiners (Sec. 482) and Primary Examiners and the Examiner in charge of interferences (Sec. 4909).

Respectfully submitted by

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No. 56.

In the Supreme Court of the United States.

OCTOBER TERM, 1906.

THE UNITED STATES EX REL. GEORGE A. LOWRY AND PLANTERS COMPRESS COMPANY, PLAINTIFFS IN ERROR,

v.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR THE UNITED STATES.

In the Supreme Court of the United States.

OCTOBER TERM, 1906.

THE UNITED STATES EX REL. GEORGE A. Lowry, and Planters Compress Company, plaintiffs in error,
v.
FREDERICK I. ALLEN, COMMISSIONER OF Patents.
} No. 56.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR THE UNITED STATES.

STATEMENT.

This is a writ of error to the Court of Appeals of the District of Columbia to review a judgment denying the right to a mandamus to the Commissioner of Patents directing him to permit an appeal within his office in an interference case and reversing the Supreme Court of the District which, without opinion, granted the writ.

The interference was declared under section 4904, Revised Statutes, between a patent granted to plaintiffs in error and an application filed by one Spoon, both relating to a cotton bale. Plain-

tiffs' patent, No. 661475, was granted in 1900. Spoon's application was filed September 10, 1901. The interference was declared to determine the priority of invention. (Sec. 4904, Rev. Stat.) Plaintiffs alleging it was without good reason, moved dissolution. The primary examiner denied the motion and they appealed to the examiners in chief. (Sec. 4909, Rev. Stat.) This appeal was dismissed, and thereafter they applied to the Supreme Court of the District for a mandamus commanding the Commissioner "to cause to be reinstated and to reinstate and take jurisdiction of your petitioners' said appeal, and to entertain and consider the merits thereof, and decide the same upon the merits."

The petition in substance alleges—

That Lowry as inventor and the Planters' Compress Company as assignee secured patent No. 661475 upon a bale of fibrous material;

That an interference was declared between that patent and application No. 74985, filed by Spoon, covering a bale of fibrous material;

That Lowry moved to dissolve the interference under rule 122, and his motion was granted;

That Spoon thereupon appealed to the examiners in chief, who affirmed the decision;

That Spoon took an appeal to the Commissioner in person and also filed a petition asking him "to remand the said interference to the primary examiner for reconsideration of the question of operativeness of the Spoon press to make the issue

bale and for leave to file affidavits in support of operativeness;"

That this petition was granted, and afterwards the examiner "found the Spoon press operative to make the issue bale, if the press of Lowry was operative to make the issue bale, and reversed previous decisions dissolving the interference;"

That Lowry thereupon appealed to the examiners in chief under sections 482 and 4909 Revised Statutes;

That Spoon moved to dismiss the appeal for lack of jurisdiction and the motion was granted; and that the Commissioner of Patents refused to direct them to hear and determine the same.

Alleging it was the duty of the examiners in chief to determine the appeal and that upon their refusal the Commissioner should direct them so to do, petitioners prayed for an appropriate writ of mandamus.

The Return—

The defendant in error admitted the various actions set forth in the petition but denied it was the duty of the examiners-in-chief to entertain and decide the appeal. He declared "that the primary examiner's decision was not the rejection of a claim or a final adverse decision in the interference, but was a mere ruling upon an interlocutory motion and was not appealable. He further avers that the decision was not adverse to Lowry's claimed rights as the patentee, since that is the very matter to be determined in the interference pro-

ceeding which the primary examiner refused to dissolve. Lowry will have the right of appeal, if at all, only in case the final decision in the interference is adverse to him." (R., 12–21.)

Replication—

Plaintiffs filed a replication (R., 13, 14), practically admitting the examiner's decision was interlocutory and not final and alleging that the right of appeal from such a ruling existed.

No written opinion was filed by the trial court. The elaborate opinion of the Court of Appeals appears in the record at page 29, and to it especial attention is invited.

Statutes and Patent Office Rules—

> R. S., SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.
>
> R. S., SEC. 4909. Every applicant for a

patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief, having once paid the fee for such appeal.

R. S., SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief he may, on payment of the fee prescribed, appeal to the Commissioner in person.

R. S., SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SEC. 9. (Act of February 9, 1893.) That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

R. S., SEC. 482. The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it

shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

R. S., SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

RULE 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for altho the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

RULE 97. When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences the files and drawings; notices of interference for all the parties (as specified in Rule 103), disclosing the name and residence of each party and that of his attorney, and of any

assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count should be specified. The primary examiner shall also forward to the examiner of interferences for his use a statement disclosing the applications involved in interference, fully identified, the name and residence of any assignee, and the names and residences of all attorneys, both principal and associate, and arranged in the inverse chronological order of their filing as completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner will notify each of said principal parties, and also the attorney, of this fact.

RULE 101. Upon the institution and declaration of the interference, as provided in Rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 122, as therein provided.

RULE 102. When the notices of interference are in proper form, the examiner of interfer-

ences will add thereto a designation of the time within which the preliminary statements required by Rule 110 must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

RULE 108. When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of each other's file-wrappers, and so much of their contents as relate to the interference, after the preliminary statements referred to in Rule 110 have been received and approved; but information of an application will not be furnished by the office to an opposing party, except as provided in Rules 97 and 103, until after the approval of such statement.

RULE 110. Each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixt by the Office, showing the following facts:

(1) The date of original conception of the invention set forth in the declaration of interference.

(2) The date upon which a drawing of the invention was made.

(3) The date upon which a model of the invention not claimed as a reduction to practise was made.

(4) The date upon which the invention was first disclosed to others.

(5) The date of the reduction to practise of the invention.

* * * * *

RULE 122. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which deny the patentability of an applicant's claim, or his right to make the claim, should, if possible, be made not later than the twentieth day after the statements of the parties have been received and approved.

[The foregoing was amended July 31, 1906, so as to read: *Motions to dissolve an interference* (*1*) *upon the ground that there has been such informality in declaring the same as will preclude a proper determination of the question of priority of invention, or* (*2*) *which deny the patentability of an applicant's claim, or* (*3*) *which deny his right to make the claim, or* (*4*) *which allege that counts of the issue have different meanings in the cases of different parties*, should, if possible, be made not later than the *thirtieth* day after the statements of the parties have been received and approved.] Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain

when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the primary examiner, if no appeal has been taken therefrom, at the expiration of the time limited for appeal the examiner will return the files and papers, with his decision, to the examiner of interferences. Such decision will be binding on the examiner of interferences unless reversed or modified on appeal. (Rule 124.)

Motions to shift the burden of proof should be made before and will be determined by the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

RULE 124. Appeal may be taken directly to the Commissioner from decisions on all motions except the following: (1) On motions to dissolve which deny the patentability of applicant's claim; (2) on motions to dissolve which deny the right of an applicant to make the claim; (3) on motions involving the merits of the invention. Decisions on these motions, when appealable, go to the examiners in chief, *in the first instance*, and upon such appeals the questions *shall* be heard *inter partes*.

From a decision of the primary examiner affirming the patentability of the claim or

the applicant's right to make the same no appeal can be taken.

[Rule 124 was amended July 31, 1906, to read: *Where, on motion for dissolution, the primary examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable, or that a party has no right to make a claim, or that the counts of the issue have different meanings in the cases of different parties, he shall at once reject such claims as may be affected and shall set a time for reconsideration; after reconsideration, if he adheres to his original conclusion, he will make the previous rejection final and fix a limit of appeal. The appeal must go to the examiners in chief in the first instance and will be heard inter partes. If the appeal is not taken within the time fixed, it will not be entertained except by permission of the Commissioner.*

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.]

RULE 126. The examiner of interferences or the examiners in chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to

any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may, before judgment on the question of priority, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

RULE 130, July 31, 1906. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent at final hearing before the examiner of interferences as a basis for the decision upon priority of invention, and upon appeals from such decision. A party shall not be entitled to take such step, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon the ground in question, or shows good reason why such a motion was not presented and prosecuted.

146. In interference cases parties have the same remedy by appeal to the examiners in chief, to the Commissioner, and to the Court of Appeals of the District of Columbia, as in *ex parte* cases.

Practise in Patent Office on motion to dissolve interference and the questions involved in Lowry's motion to dissolve.

There are in the Patent Office forty primary examiners, each of whom has charge of applications relating to inventions concerning which he has expert knowledge. When he finds a conflict between two applications otherwise allowable he declares an interference and sends the papers to the examiner of interferences to determine who was the first inventor and entitled to the patent.

There is only one examiner of interferences who takes charge of all interferences declared by the forty primary ones. Neither examiner is superior to the other, and all are tribunals of original jurisdiction, having charge of different questions.

The board of three examiners in chief has jurisdiction to entertain appeals from a primary examiner rejecting claims and from decisions of the examiner of interferences in interference cases.

The primary examiner necessarily declares interferences, since he is the only one who examines all applications relating to his art and who primarily knows when claims conflict. Before declaring an interference, the examiner must consider and decide whether the parties claim the

same invention, and whether the invention would be patentable under any circumstances. He makes decision without a hearing. Under the rules applications are preserved in secrecy. After an interference is declared and parties have filed their preliminary statements, each is permitted to see his opponent's papers. (Rule 108.)

As the original declaration of interference is made *ex parte*, it is the practise to permit either party to move for its dissolution. The motion is in effect a request for reconsideration, after argument, of the action declaring the interference, and raises only those questions which should have been originally considered by the examiner. It is now and has been for a great many years the practise of the Patent Office to have preliminary motions to dissolve interferences determined by the primary examiner who declared the interference, and they are permitted only at the beginning of the proceedings before taking testimony. All other preliminary and interlocutory motions as to the conduct of the proceedings are made before and determined by the examiner of interferences. The officials of the Patent Office have considered it wise thus to divide the jurisdiction as to preliminary matters. All of these might have been left for determination by the examiner of interferences, and there is nothing to prevent the Commissioner from so changing the present practise.

The Commissioner may, on interlocutory appeal, review rulings upon certain preliminary questions by the examiner of interferences and primary examiners under Rule 122. In neither case is the review granted because of statutory requirement, but because in the exercise of administrative discretion this seems wise. This right of review, however, is limited by the rule which provides for it. (Rule 124.) Such appeals are in the nature of special interlocutory appeals and are matters of discretion.

Rule 124 permits review of some decisions by the examiners-in-chief and others by the Commissioner. When a motion to dissolve is *granted* because the claim constituting the subject-matter of controversy is not patentable, or because one party has no right to make that claim, an appeal lies to the examiners-in-chief. In such a case, unless the matter is then reviewable, the decision obviously ends the interference. If the motion is *denied* there is no immediate review, but the examiners-in-chief pass on the entire subject upon appeal from the final judgment. Rule 124 provides there shall be no interlocutory appeal from a finding that the issue is patentable or that a party has the right to make the claim.

The "right of an applicant to make the claim," mentioned in the rule, has nothing whatever to do with anything done or rights acquired by the opposing party in the interference. It has refer-

ence solely to the applicant's *ex parte* right to a patent upon his application. If, e. g., the application is insufficient to support the claim, or device disclosed is found inoperative, the applicant has no right to make the claim. A finding favorable to his right is not a decision in itself adverse to the claim of the opposing party, since the latter may be the first inventor and show it by proof.

Question involved in Lowry's motion—

The present interference was declared because in his application Spoon made a claim the same as one appearing in Lowry's patent. Where two parties claim the same thing an interference is necessary in order to decide between them, and to determine whether the applicant is entitled to the patent sought.

The petition for mandamus states (R., 2–3) Lowry's motion for dissolution alleged that Spoon's press as disclosed in his application is inoperative, and that therefore he has no right to make the claim. Admittedly, Spoon makes plaintiffs' patented claim, but it is alleged he has no right to. The examiner ruled there was nothing upon the face of the papers showing Spoon's press inoperative, and the parties should proceed with the interference by taking proof. The question of operativeness is the only thing particularly mentioned in the petition for mandamus as having been decided by the examiner.

ARGUMENT.

I.

The decisive question is whether it was the plain, clear ministerial duty of the Commissioner of Patents to permit plaintiffs' appeal to the examiners in chief from the primary examiner's refusal to dissolve the interference.

In *Ex Parte Cutting* (94 U. S., 14)—a petition for mandamus to compel allowance of an appeal—this court said the petitioners must "show that they have a clear right to an appeal, which has been refused."

High's Extraoradinary Legal Remedies, 248:

> But to warrant the interference in this class of cases it must appear that the person seeking the relief is clearly entitled to an appeal, and when this does not appear the writ will be refused. And mandamus will not lie to compel a court to settle a statement for the purpose of an appeal from a judgment which is only interlocutory and from which no appeal lies. Nor will the writ go to compel the allowance of an appeal from orders, the granting of which rests wholly within the discretion of the court.

Under the statutes an interference is declared solely "to determine the question of priority of invention." No such determination was made in the present interference. Lowry's motion was a request that the proceeding be stopt or dissolved

without deciding that point, and he seeks to appeal from a refusal. He did not ask judgment in his favor, but that no judgment as to priority be rendered.

Defendant maintains that the decision complained of is interlocutory and can not be reviewed on a direct appeal before the final judgment.

The following propositions are advanced:

1. The examiner's refusal to dissolve the interference does not terminate it and is not final.

2. Preliminary and interlocutory rulings are not appealable prior to final judgment unless expressly made so by statute.

> It is a universal rule that, except as provided by statute, no appeal can be prosecuted from a proceeding taken prior to final judgment or decree. (Enc. of Pl. & Pr., vol. 2, p. 81.)

3. The same doctrine applies to patent appeals, and no statute expressly makes interlocutory matters appealable.

4. To permit appeals on interlocutory motions in interferences would protract litigation in the Patent Office to an unbearable degree. The general terms in section 4909, Revised Statutes, do not require such a result.

5. The decision mentioned in section 4909—on the question of priority of invention—is the only one which section 4904 requires the Patent Office to render.

6. When the examiners in chief were created and right of appeal to them in interference cases given (sec. 2, act Mar. 2, 1861, 12 Stat., 246), and when section 4909, Revised Statutes, in its present words became law, the rules of the Patent Office did not permit interlocutory motions to dissolve interferences. Such motions were not permitted until 1871, ten years after the passage of the original act relating to appeals. Rulings upon such motions were not, therefore, the decisions from which that section was designed to give appeals.

7. If the question raised by motion to dissolve so affects the rights of parties to the interference as to permit a review, it should be on appeal from the final decision.

8. So long as plaintiffs may appeal from the final judgment they are adequately protected. This right is clearly given by new Rule 130 and never denied by any rule.

9. At no time since the board of examiners in chief was established has the Patent Office permitted appeal to them from preliminary or interlocutory decisions denying motions to dissolve interferences. This uniform and long-continued construction of the law by the officials is entitled to great weight.

II.

The statutes do not provide for interlocutory appeals.

The statutes do not specifically mention interlocutory rulings as appealable, but plaintiffs claim their terms are so broad as to include them.

The word in the statutes is undoubtedly broad, but that only a final decision is referred to is reasonably clear. Congress framed the law with knowledge that by long usage the term "decision" in a suit or judicial proceeding means a final determination and not a mere preliminary ruling. If a different use of the word had been intended that would have been made clear. All interlocutory rulings are included, if any are.

Section 4904, Revised Statutes, specifically provides for a decision on "priority of invention" and an appeal therefrom, and no other in an interference is specifically mentioned in the statutes. The decision mentioned in section 4909 is the one described in section 4904.

The statutes do not state how questions are to be raised and determined in interference proceedings, and the Commissioner has made controlling rules.

By analogy to court practise interlocutory motions in interferences should be allowed, as has been done for many years. Analogy to the same practise prohibits appeals from rulings on such motions.

III.

No reasons exist for presuming an intent to make interlocutory rulings in interferences appealable prior to a final judgment.

A consideration of the nature of interferences shows they are much like proceedings in equity, and present no greater reasons for permitting piecemeal appeals and prolonged litigation. An equity suit instituted under section 4918, Revised Statutes, touching conflicting patents is strictly analogous to an interference in the Patent Office. Before the grant of the patent the proceeding is in the Patent Office and afterwards in the courts. The question at issue is the same in both cases and the procedure similar.

The judicial character of interference proceedings was declared by this court in *United States* v. *Duell* (172 U. S., 576):

> Now, in deciding whether a patent shall issue or not, the Commissioner acts on evidence, finds the facts, applies the law, and decides questions affecting not only public but private interests; and so as to reissue, or extension, or on interference between contesting claimants; and in all this he exercises judicial functions.

Congress likewise recognized their judicial nature by providing an appeal to the Court of Appeals of the District.

If plaintiffs may appeal to the examiners-in-chief under section 4909 from the examiner's

refusal to dissolve an interference, they may further appeal to the Commissioner under section 4910 and to the Court of Appeals under section 4911, Revised Statutes, and section 9, act of February 9, 1893. Section 4909 says "every party to an interference may appeal" to the examiners-in-chief; section 4910 refers to section 4909 and adds "such party" may appeal to the Commissioner; and section 9, act of February 9, 1893, provides "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

In *Westinghouse* v. *Duncan* (66 O. G., 1009; 2 App. D. C., 131)—appeal to the Court of Appeals upon refusal by the Patent Office of motion to reform the issue—the court said:

> In our opinion it was not the intention of Congress, in the employment of the general terms of the statute, to grant the right of appeal to this court from mere interlocutory or preliminary orders or rulings in interference proceedings. By such rulings no definite determination of the merits of the case is made. The ultimate determination in such cases by the Commissioner of Patents is of the question of priority of invention, and that is the only decision from which an appeal will lie to this court in such cases.

In *Cross* v. *Phillips* (87 O. G., 1399, 14 App. Cases, 228), the same court said:

> Appeals do not lie to this court from all or any preliminary decisions in matters of

interference, though seriously affecting the rights of the parties, but only from those wherein the priority of the claim to the invention has been finally awarded. (*Westinghouse* v. *Duncan*, C. D., 1894, 170; 66 O. G., 1009; 2 App. D. C., 131, 134.)

If, then, the exercise of the discretion of the Commissioner in the matter of allowing and refusing leave to amend preliminary statements be subject to review at all, it must be confined to those cases where the question comes up properly with the appeal from the decision on the merits, and where it can be made clearly to appear that this discretion has been abused to the extent of causing a palpable miscarriage of justice.

In *Hulett* v. *Long* (89 O. G., 1141, 15 App. Cases, 284), the court said:

The questions raised upon this motion to dissolve were of an interlocutory character and did not involve in their determination the question of priority of invention, and from the determination of such questions as those raised by the motion no appeal is allowed to this court. The appeal allowed to this court by the act of Congress of February 9, 1893, in cases of interference is for the purpose, and that alone, of having the final decision of the Commissioner of the Patent Office on the question of priority of invention reviewed and determined as that question is contemplated and provided for in section 4904 of the Revised Statutes of the United States, and not for the purpose of

> having decisions upon collateral or interlocutory questions reviewed and decided. If all such collateral and interlocutory proceedings in the Patent Office were the subjects of appeal to this court, the proceedings for patents might be made almost interminable, to say nothing of the enormous costs that would be incurred in prosecuting and defending against such appeals.

Innumerable preliminary and interlocutory questions may be raised in interference proceedings, and experience has shown they are often used to delay or harass opponents. The court below, in reference to this, said (R. 31)—

> It is known to all who are familiar with the practice in interference proceedings that by motions, petitions, and appeals of every conceivable character that the ingenuity of the skilled attorney can devise interferences can be and are prolonged for years, to the injury of the public, and often to the financial ruin of the parties. It does not appear when the present interference was declared, but in view of all the proceedings had, as disclosed by the record, it has been a long time, and no testimony has yet been taken. Should we affirm the decision of the court below, the reasons for which are not set forth, and reverse the practice of the Patent Office as it has stood unchanged for at least twenty-five years, we would be placing still another burden of successive piecemeal appeals upon the unfortunate interferant. * * *

IV.

Circumstances surrounding passage of appeal statute show interlocutory motions are not appealable.

It may be urged that section 4909, Revised Statutes, referred to an existing state of things in the Patent Office, and, when construed in the light of the practise, means that interlocutory motions should be appealable.

Any such view would be refuted by an examination of the rules from 1861 to the present. They did not permit an interlocutory motion to dissolve an interference in 1861, when the original act permitting appeals to the examiners in chief was past, nor in 1870, when the act in its present form was enacted. No such motion was permitted until August 1, 1871.

In the appeal act, therefore, the lawmakers were not referring to the interlocutory motions, but to the only decision then being rendered by the Patent Office in interference cases, namely, one upon priority of invention.

Section 2, act of March 2, 1861, follows:

> SEC. 2. And be it further enacted, That, for the purpose of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific

> ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

The act of 1870 contained the provisions of section 4909.

The first reference in the rules to a dissolution of the interference because improperly declared is found in the edition of August 1, 1869, eight years after the passage of the appeal act.

Rule 58 of that edition:

> Cases of interference will, when the issue is made up and the testimony taken, be tried before an examiner specially detailed for that purpose. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties.

This was the only rule referring to the subject when the act of 1870 passed.

Rule 59 of July 5, 1870:

> Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists.

The rules of August 1, 1871, included the following (Rule 59):

> A motion for a dissolution of an interference on the ground that it was improperly declared, if made before the taking of testimony, will be heard by the primary examiner who declared the interference.

This was the first provision for an interlocutory motion for dissolution. In the rules of September 1, 1873, it was changed, as follows:

> A motion for a dissolution of an interference on the ground that it was improperly declared, if made before the taking of testimony, will be heard by the primary examiner who declared the interference. Upon such hearing the primary examiner will recommend the granting or refusal of such

motion, and the examiner in charge of interferences will order accordingly. (Last paragraph of Rule 59.)

In the rules of April 1, 1875, it was further changed as follows:

> 59. An interference will not be declared until the subject-matter involved is decided to be patentable. If after being declared it is found that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of right between the parties it will be dissolved, and an appeal may be taken to the Commissioner in person.

The rules of November 1, 1876, contained the following:

> 59. After the declaration of the interference and before the time for filing the preliminary statements has expired, motions to dissolve the same on the ground of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. An appeal from his decision may be taken to the Commissioner in person; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art

the interference will be dissolved and the matter decided upon can be proceeded with ex parte.

With slight modifications this continued in force until May, 1879, when it was directed that all such motions should be made before the Commissioner.

On December 1, 1879, the following rules were adopted:

116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in rules 97, 101, and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless revised or modified on appeal. From a decision of the primary examiner on such motion, denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken ex parte to the examiners in chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken.

117. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of priority between the parties, and all other lawful motions except those mentioned in rule 116, will be made before the tribunal having jurisdiction at the time. * * *

118. Appeal may be taken directly to the Commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant's claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners in chief. (See Rules 116, 141.)

These rules contain the provisions to which plaintiffs object. The Patent Office has never permitted appeals to the examiners in chief from the refusal of an interlocutory motion to dissolve an interference.

V.

Rules of Patent Office permit review of interlocutory ruling with final judgment, and are not inconsistent with law.

Rule 122 provides that the primary examiner shall pass upon motions for dissolution and that his decision thereon is binding upon the examiner of interferences; but it does *not* provide that such conclusion is binding upon the appellate tribunals.

Nothing prevents the examiners in chief, the Commissioner of Patents, or the Court of Appeals from reviewing the action of the primary examiner upon appeal from a final decision. If the ruling of the primary examiner so influences the disposition of the case by the examiner of interferences as to lead to an erroneous final judgment, that may be reviewed and reversed. The rules do not cut off the right of review, but merely regulate the procedure and time therefor. This is not unreasonable and is in line with the practise of courts.

The court below in this case said (R., 38–39):

> * * * whatever right a party to an interference has to contest the right of his adversary to make the interfering claim, such right, if denied, is reviewable, if at all, upon the final decision of the question of priority, and such right of appeal as he has to have that question decided is to be considered on the hearing of the statutory appeals allowed from the decision of the question of priority by the examiner of interferences.

(See *Cross* v. *Phillips*, 14 App. Cases, 228; *Seeberger* v. *Dodge*, 114 O. G., 2382 (Jan., 1905); *Podlesak* v. *McInnerney*, 120 O. G., 2127; 26 App. Cases, 399.)

Amended Rules 122 and 124, and Rule 130 above quoted, make it clear the examiners in chief and the Commissioner will review, on appeal from final decision, the question which plaintiff in error now seeks to force them to consider.

In the case of *Pohle* v. *McKnight* (119 O. G., 2519), the Commissioner of Patents reviewed and determined a question similar to that raised by plaintiffs in error, but he did it upon appeal from a final decision. This was prior to the last amendment of the rules.

VI.

Ruling that Spoon has right to make claim is not final.

The examiner's ruling that Spoon has a right to make the claim embodied in plaintiffs' patent and that his press is operative, only means that Spoon made out a *prima facie* case. Plaintiffs may take proof to overcome the supposed *prima facie* case, or they may stand upon their motion—practically a demurrer—and allow judgment to be entered against them. They may then appeal and obtain a review by three successive appellate tribunals. They should not be permitted to take three appeals on the interlocutory ruling. It is no great hardship to require them to elect whether they will stand upon their demurrer or take proof.

The conclusion that in the absence of proof Spoon's press must be regarded as operative is a very different thing from a final decision to that effect. If Spoon's device were finally held operative it would still be necessary to determine whether plaintiffs' claim is superior. The ruling in question, therefore, does not approach a final decision against plaintiffs.

VII.

Long-established practise of the Patent Office is entitled to great weight.

The fact that the Patent Office has never permitted appeals to the examiners in chief from denial of an interlocutory motion to dissolve an interference, is entitled to much consideration.

The Commissioners of Patents were interested, were competent to judge of their meaning, and were undoubtedly informed as to the intentions and purposes of the several statutes. For forty odd years they have denied the right now claimed by plaintiffs.

No published decisions of the Commissioners exist prior to about 1870. Commissioner Leggett, August 23, 1871, in *Crane and Rogers*, C. D., 1871, said:

> The object of the interference is, by the law and by the office rules of practice, solely for the purpose of determining priority of invention between contending parties. There is no law for declaring or continuing an interference on any other question.
>
> The examiner of interferences has no jurisdiction of other matters, and therefore can give no final judgment except upon questions of priority of invention and such preliminary and interlocutory questions as may be necessary in determining priority.
>
> The board of examiners in chief and the

> Commissioner, while acting in his judicial capacity, are subject to the same limitations when trying interference cases.

That decision manifestly means interlocutory matters are to be considered upon appeal only so far as they affect the judgment upon the real question in the interference, and they are brought up by appeal from the final judgment.

In *Bate Refrigerating Co.* v. *Sulzberger* (157 U. S., 1; 70 O. G., 1633) this court said:

> * * * If the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions, this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

I respectfully ask that the judgment of the court below be affirmed.

J. C. McReynolds,
Assistant Attorney-General.

John M. Coit,
Attorney for the Commissioner.

October, 1906.

O

Supreme Court of the United States.

No. 56.—October Term, 1906.

The United States ex rel. George A. Lowry and Planters Express Company, Plaintiffs, in Error, vs. Frederick I. Allen, Commissioner of Patents.	In error to the Court of Appeals of the District of Columbia.

[December 10, 1906.]

Mr. Justice McKenna delivered the opinion of the Court.

This is a petition for mandamus filed in the Supreme Court of the District of Columbia, requiring the Commissioner of Patents to direct the board of examiners in chief to reinstate and take jurisdiction of the appeal of petitioners from the decision of the primary examiner, refusing to dissolve an interference between a patent granted to him and an application for a patent by one William L. Spoon. The Supreme Court granted the mandamus. Its judgment was reversed by the Court of Appeals.

The question in the case is, whether the rule of the Patent Office which denies an appeal from a ruling of a primary examiner, upon motion to dissolve an interference, is contrary to the Revised Statutes, and therefore void. Rule 124 provides that "from a decision of a primary examiner affirming the patentability of the claim or the applicant's right to make the same, no appeal can be taken."

Plaintiffs in error attack the rule as inconsistent with the sections of the Revised Statutes which provide for interferences. These sections are inserted in the margin.*

*R. S., Sec. 4804. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

R. S., Sec. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge

The facts are as follows: Lowry was granted a patent for a bale of fibrous material January 29, 1897. An interference was declared between his patent and application of one William Spoon, to which interference Lowry was made a party. He moved to dissolve the interference upon the ground, among others, that Spoon's press was inoperative. The primary examiner granted the motion and Spoon appealed to the board of examiners in chief, who confirmed the decision. Upon petition of Spoon the Commissioner of Patents remanded the case to the primary examiner for further consideration, and the latter officer, upon the filing of additional affidavits, decided that Spoon's application disclosed an operative device. From this decision an appeal was taken to the board of examiners in chief, which was dismissed by that board for want of jurisdiction. Thereupon Lowry petitioned the Commissioner to direct the board to issue an appeal. The petition was denied, the Acting Commissioner remarking:

"The rule prohibiting an appeal from a decision upon a motion holding that a party has the right to make the claim of the issue is in accordance with the practice which has prevailed in this office for many years and has the support of all decisions of the courts which have been rendered on the subject. There seems to be no reason for regarding it as inconsistent

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of interferences in such case, to the board of examiners in chief, having once paid the fee for such appeal.

R. S., SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief he may, on payment of the fee prescribed, appeal to the Commissioner in person.

R. S., SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SEC. 9. (Act of February 9, 1893.) That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

R. S., SEC. 482. The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

R. S., SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

with the statute. It seems very clear that the decision in this case is not a final adverse decision, since it is not a ruling that Lowry is not entitled to his patent. That is a matter which may be determined in the further proceedings, and therefore it is clear that the decision relates to a mere interlocutory matter.

"The petition is denied."

Lowry filed another petition, appealing to the Commissioner "in person," to direct the board of examiners in chief to entertain his appeal. The petition was considered and denied. In passing on the petition the Commissioner said:

"Under the express provisions of Rule 124 there is no appeal to the examiners in chief from such decision rendered on an interlocutory motion. It is believed that there is nothing in that rule inconsistent with law, and that therefore it has the force of law. The right of appeal in interferences given in general terms in the statute is a very different thing from the right of appeal on all motions in the interference. To permit appeals on motions would multiply litigation and extend the proceedings in interferences beyond all reasonable limits. It would work great hardship to parties. The appellate tribunals of this office are no more required to give cases piecemeal consideration than are the appellate courts. The whole case should be ready for appeal when the appeal provided for by the statute is taken.

* * * * * *

"It is to be particularly noted that there has been no decision as to the rival claims of the parties to this interference. It has not been decided which party is entitled to the patent. If it should at any time be decided that Spoon is entitled to the patent, Lowry will have the right of appeal, but until such final decision is rendered the statute gives him no right of appeal.

"It would seem upon general principles of law that Lowry could then present for determination by his appeal any question which in his opinion vitally affects the question which party is entitled to the patent. The only ground upon which he can reasonably claim the right of appeal on this motion is that the question vitally affects his claimed right to a patent, and if it does that, he can raise it at final hearing and contest it before the various appellate tribunals, including the Court of Appeals.

"The refusal to permit the present appeal on motion is therefore not a denial of an opportunity to have the matter reviewed by the several appellate tribunals mentioned in the statute."

And further: "No good reason is seen for changing the provisions in Rule 124 here in controversy, which was adopted and approved by a long line of Commissioners of Patents, among whom have been some of the ablest patent lawyers in the country, and which rule has been acquiesced in by patent attorneys practicing before the office for the last quarter of a century."

There is quite a sharp controversy between the parties as to the effect of the ruling of the Commissioner. Plaintiffs in error are apparently con-

vinced that the ruling of the primary examiner involves a fundamental right which, if not decided on his appeal, will be forever foreclosed to him for review. A different view is expressed by defendant in error. However this may be, we think the question in the case is in quite narrow compass. The statutes involved are not difficult of interpretation. The determining sections are 482, 483, 4904 and 4909. Plaintiffs in error put especial stress upon sections 482 and 4909. Section 482 provides for the appointment of examiners in chief, "whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners . . . in interference cases." Section 4906 provides that "every party to an interference may appeal from the decision of the primary examiner in such case to the board of examiners in chief . . ." The contention is that this section gives the right of appeal unreservedly and any limitation of it by a rule is void, Such might not be the result, even if there was no qualification of those sections in other sections. As said by the Commissioner, "the right of appeal in interferences given in general terms in the statute is a very different thing from the right of appeal on all motions in the interference." It certainly could not have been the intention to destroy all distinctions in procedure. But we are not left to inference. The statute is explicit. It limits the declaration of interferences to the question of priority of invention. Section 4904 provides that in case of conflict of an application for a patent with a pending application or with an unexpired patent (as in the case at bar), the Commissioner shall give notice thereof, "and shall direct the primary examiner to proceed to determine the question of *priority of invention*." (Italics ours.) And it is provided that the Commissioner shall issue a patent to the party adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner or examiners in chief, as the case may be. The history of the sections and the rules are gone into at length by the Court of Appeals in its opinion. We need not repeat the discussion. It answers the detailed reasoning of plaintiffs in error. We concur with the views expressed, that the statutes provide only for appeals upon the question of priority of invention. Appeals on other questions are left to the regulation of the Patent Office under the grant of power contained in section 483.

Judgment affirmed.

Mr. Justice PECKHAM and Mr. Justice DAY dissent.

True copy.

Test:

Clerk Supreme Court, U. S.